

ESTTA Tracking number: **ESTTA351998**

Filing date: **06/09/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91184456
Party	Plaintiff L'Oreal USA, Inc.
Correspondence Address	Robert L. Sherman Paul, Hastings, Janofsky & Walker LLP 75 East 55th Street New York, NY 10022 UNITED STATES rls@paulhastings.com
Submission	Plaintiff's Notice of Reliance
Filer's Name	Natalie G. Furman
Filer's e-mail	rls@paulhastings.com
Signature	/NGF/
Date	06/09/2010
Attachments	Opposer's Notice of Relance (Part 2).pdf ( 4 pages )(226216 bytes ) Exhibit E-01.pdf ( 5 pages )(366364 bytes ) Exhibit E-02.pdf ( 4 pages )(305604 bytes ) Exhibit E-03.pdf ( 3 pages )(267648 bytes ) Exhibit E-04.pdf ( 3 pages )(265983 bytes ) Exhibit E-05.pdf ( 3 pages )(282981 bytes ) Exhibit E-06.pdf ( 3 pages )(285041 bytes ) Exhibit E-07.pdf ( 3 pages )(270000 bytes ) Exhibit F-01 [Complete File History for LOREAL OUR WORLD] 300 dpi.pdf ( 41 pages )(1283886 bytes ) Exhibit F-02 [Complete File History for LOREAL EXTRA VOLUME COLLAGENE] 300 dpi.pdf ( 77 pages )(4073895 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736  
Published in the Official Gazette on May 6, 2008  
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC.,

Opposer,

v.

ROBERT VICTOR MARCON,

Applicant.

Opposition No. 91184456

**ORAL ARGUMENT REQUESTED**

**OPPOSER'S NOTICE OF RELIANCE**

**(Part 2)**

Pursuant to Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 704.02 and 37 CFR §§ 2.120 and 2.122, L'Oréal S.A. and L'Oréal USA Creative, Inc. (collectively, "L'Oréal" or "Opposer") hereby offers into evidence and intends to rely on the following:

5. Certified copies of federal registrations owned by Opposer, showing the current status of and current title to the registrations, which are attached hereto as Opposer's Exhibit E.
  - a. **Opposer's Exhibit E-1:** U.S. Registration No. 540,541 for L'ORÉAL, certified on May 18, 2010 to be in full force and effect with title in Opposer.
  - b. **Opposer's Exhibit E-2:** U.S. Registration No. 661,746 for L'OREAL, certified on May 17, 2010 to be in full force and effect with title in Opposer.

- c. **Opposer's Exhibit E-3:** U.S. Registration No. 3,109,618 for L'OREAL  
ENDLESS, certified on May 17, 2010 to be in full force and effect with title in  
Opposer.
- d. **Opposer's Exhibit E-4** U.S. Registration No. 3,115,751 for L'OREAL E-  
STRAT CHALLENGE, certified on May 17, 2010 to be in full force and effect  
with title in Opposer.
- e. **Opposer's Exhibit E-5:** U.S. Registration No. 3,081,932 for L'OREAL  
PROFESSIONNEL ELITE, certified on May 17, 2010 to be in full force and  
effect with title in Opposer.
- f. **Opposer's Exhibit E-6:** U.S. Registration No. 3,281,234 for L'OREAL  
TECHNIQUE, certified on May 17, 2010 to be in full force and effect with title  
in Opposer.
- g. **Opposer's Exhibit E-7:** U.S. Registration No. 3,453,753 for L'OREAL  
INFINIUM, certified on May 14, 2010 to be in full force and effect with title in  
Opposer.

6. File histories of Opposer's allowed applications for L'OREAL- formative marks,  
which are attached hereto as Opposer's Exhibit F.

- a. **Opposer's Exhibit F-1:** Complete file history, dated May 12, 2010, for  
Opposer's Application Serial No. 77/354,359 for L'OREAL OUR WORLD,  
which was allowed on July 28, 2009 for "hair shampoos and conditioners for  
children" in International Class 3.
- b. **Opposer's Exhibit F-2:** Complete file history, dated May 12, 2010, for  
Opposer's Application Serial No. 77/477,820 for L'OREAL EXTRA VOLUME

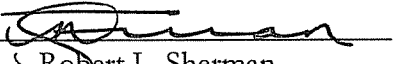
COLLAGENE, which was allowed on July 21, 2009 for “mascaras” in  
International Class 3.

**ORAL ARGUMENT REQUESTED**

Dated: June 9, 2010

Respectfully submitted,

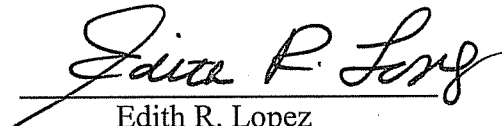
PAUL, HASTINGS, JANOFSKY  
& WALKER LLP

By:   
Robert L. Sherman  
Natalie G. Furman  
75 E. 55th Street  
New York, New York 10022  
212-318-6000  
Attorneys for Opposer

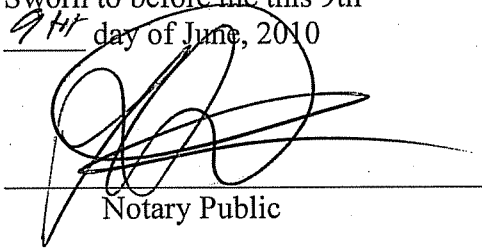
CERTIFICATE OF SERVICE

I hereby certify that the foregoing OPPOSER'S NOTICE OF RELIANCE was served this 9th day of June, 2010, by delivering a true and correct copy of same by first class mail to:

Robert V. Marcon  
3481 Sinnicks Avenue  
Niagara Falls, ON L2J 2G  
Canada

  
Edith R. Lopez

Sworn to before me this 9th  
9th day of June, 2010

  
Notary Public

**FRANK NUNZIO D'AGOSTINO**  
Notary Public, State of New York  
No. 01DA4996102  
Qualified in New York County  
Commission Expires May 11, 2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736

Published in the Official Gazette on May 6, 2008

Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC.,

Opposer,

v.

ROBERT VICTOR MARCON,

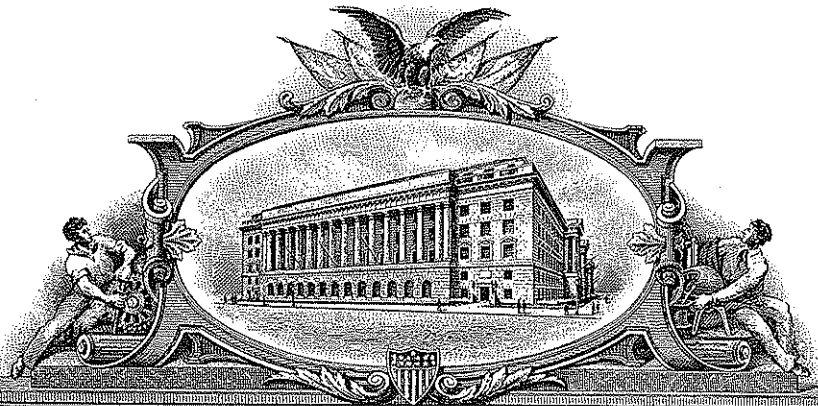
Applicant.

Opposition No. 91184456

**ORAL ARGUMENT REQUESTED**

**EXHIBIT E-1 TO OPPOSER'S NOTICE OF RELIANCE**

7239006



# THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

May 18, 2010

THE ATTACHED U.S. TRADEMARK REGISTRATION 540,541 IS  
CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND  
EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN  
THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE.

REGISTERED FOR A TERM OF 20 YEARS FROM *April 03, 1951*  
3rd RENEWAL FOR A TERM OF 10 YEARS FROM *April 03, 2001*  
SECTION 8

SAID RECORDS SHOW TITLE TO BE IN:

*L'OREAL*

By Authority of the  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office

T. LAWRENCE  
Certifying Officer



Registered Apr. 3, 1951

Registration No. 540,541

**PRINCIPAL REGISTER**  
**Trade-Mark**

**UNITED STATES PATENT OFFICE**

Eugene Schueller, Paris, France

Act of 1946

Application May 11, 1950, Serial No. 597,300

**L'ORÉAL**

**STATEMENT**

Eugene Schueller, a citizen of the Republic of France, residing at Paris, France, and doing business at 14 rue Royale, Paris, Seine, France, has adopted and is using the trade-mark shown in the accompanying drawing, for ROUGE, FACE CREAM, HAIR LOTION, HAND CREAM, EYE SHADOW, FACE LOTION, PERFUME, COLOGNE, NAIL POLISH, SUNTAN OIL AND FACE POWDER, in Class 51, Cosmetics and toilet preparations, and presents herewith five specimens (or facsimiles) showing the trade-mark as actually used in connection with such goods, the trade-mark being applied to labels which are at-

tached to packages containing the goods, and requests that the same be registered in the United States Patent Office on the Principal Register in accordance with the act of July 5, 1946.

Such trade-mark has been registered in France, Registration No. 375,704, dated March 13, 1947, and said registration is now in force and effect.

Mock & Blum, whose postal address is 10 East 40th Street, New York 16, N. Y., is designated as applicant's representative on whom notice or process in proceedings affecting the mark may be served.

EUGENE SCHUELLER.



Int. Cl.: 3

Prior U.S. Cl.: 51

United States Patent and Trademark Office  
10 Year Renewal

Reg. No. 540,541  
Registered Apr. 3, 1951  
Renewal Approved Feb. 7, 1991

TRADEMARK  
PRINCIPAL REGISTER

# L'ORÉAL

L'OREAL (FRANCE CORPORATION)  
14, RUE ROYALE  
PARIS CEDEX, FRANCE 75381, ASSIGN-  
EE BY ASSIGNMENT AND CHANGE  
OF NAME FROM SCHUELLER,  
EUGENE (FRANCE CITIZEN) PARIS,  
SEINE, FRANCE

OWNER OF FRANCE REG. NO. 375704,  
DATED 3-13-1947.

FOR: ROUGE, FACE CREAM, HAIR  
LOTION, HAND CREAM, EYE  
SHADOW, FACE LOTION, PERFUME,  
COLOGNE, NAIL POLISH, SUNTAN OIL  
AND FACE POWDER, IN CLASS 51  
(INT. CL. 3).

SER. NO. 71-597,300, FILED 5-11-1950.

*In testimony whereof I have hereunto set my hand  
and caused the seal of The Patent and Trademark  
Office to be affixed on Mar. 19, 1991.*

COMMISSIONER OF PATENTS AND TRADEMARKS

Int. Cl.: 3

Prior U.S. Cl.: 51

United States Patent and Trademark Office  
10 Year Renewal

Reg. No. 540,541  
Registered Apr. 3, 1951  
Renewal Approved Feb. 7, 1991

TRADEMARK  
PRINCIPAL REGISTER

# L'ORÉAL

L'OREAL (FRANCE CORPORATION)  
14, RUE ROYALE  
PARIS CEDEX, FRANCE 75381, ASSIGN-  
EE BY ASSIGNMENT AND CHANGE  
OF NAME FROM SCHUELLER,  
EUGENE (FRANCE CITIZEN) PARIS,  
SEINE, FRANCE

OWNER OF FRANCE REG. NO. 375704,  
DATED 3-13-1947.

FOR: ROUGE, FACE CREAM, HAIR  
LOTION, HAND CREAM, EYE  
SHADOW, FACE LOTION, PERFUME,  
COLOGNE, NAIL POLISH, SUNTAN OIL  
AND FACE POWDER, IN CLASS 51  
(INT. CL. 3).

SER. NO. 71-597,300, FILED 5-11-1950.

*In testimony whereof I have hereunto set my hand  
and caused the seal of The Patent and Trademark  
Office to be affixed on Mar. 19, 1991.*

COMMISSIONER OF PATENTS AND TRADEMARKS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736  
Published in the Official Gazette on May 6, 2008  
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC.,

Opposer,

v.

ROBERT VICTOR MARCON,

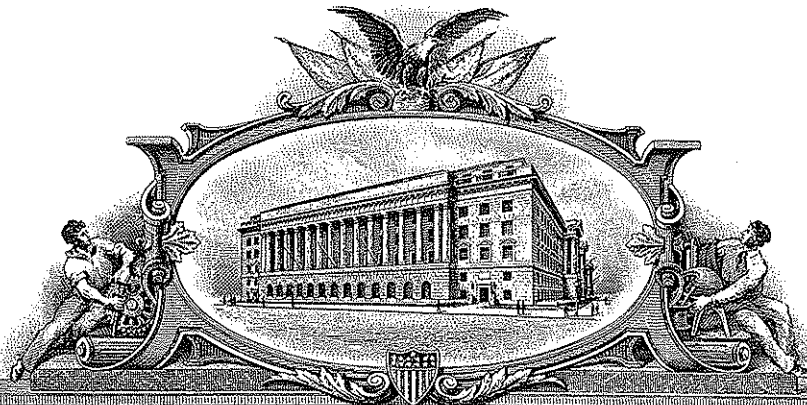
Applicant.

Opposition No. 91184456

**ORAL ARGUMENT REQUESTED**

**EXHIBIT E-2 TO OPPOSER'S NOTICE OF RELIANCE**

7239006



# THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

**UNITED STATES DEPARTMENT OF COMMERCE**

**United States Patent and Trademark Office**

**May 17, 2010**

**THE ATTACHED U.S. TRADEMARK REGISTRATION 661,746 IS  
CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND  
EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN  
THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE.**

**REGISTERED FOR A TERM OF 20 YEARS FROM *May 13, 1958*  
3rd RENEWAL FOR A TERM OF 10 YEARS FROM *May 13, 2008*  
SECTION 8 & 15**

**SAID RECORDS SHOW TITLE TO BE IN:**

***L'OREAL***

***A FRANCE SOCIETE ANONYME***

**By Authority of the  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office**

  
**M. K. CARTER**

**Certifying Officer**



Int. Cl.: 3

Prior U.S. Cl.: 51

Reg. No. 661,746

United States Patent and Trademark Office

Registered May 13, 1958

10 Year Renewal

Renewal Term Begins May 13, 1998

**TRADEMARK  
PRINCIPAL REGISTER**

**L'OREAL**

L'OREAL (FRANCE SOCIETE ANONYME),  
14, RUE ROYALE  
PARIS CEDEX, FRANCE 75381, BY  
CHANGE OF NAME FROM SOCIETE  
MONSAVON-L'OREAL, SOCIETE ANONYME  
(FRANCE CORPORATION)  
PARIS, FRANCE

OWNER OF U.S. REG. NOS. 540,541  
AND 564,689.

FOR: HAIR COLORINGS, COLOR  
RINSES, HAIR BLEACHES, COLOR DE-  
VELOPERS, COLOR INTENSIFIERS,  
AND HAIR CONDITIONERS, IN CLASS  
51 (INT. CL. 3).

FIRST USE 2-22-1921; IN COMMERCE  
2-22-1921.

SER. NO. 72-010,934, FILED 6-25-1956.

*In testimony whereof I have hereunto set my hand  
and caused the seal of The Patent and Trademark  
Office to be affixed on July 28, 1998.*

COMMISSIONER OF PATENTS AND TRADEMARKS

# United States Patent Office

661,746  
Registered May 13, 1958

## PRINCIPAL REGISTER Trademark

Ser. No. 10,934, filed June 25, 1956

### L'OREAL

Societe Monsavon-L'Oreal, Societe Anonyme (French  
corporation)  
14 rue Royale  
Paris, France

For: HAIR COLORINGS, COLOR RINSES, HAIR  
BLEACHES, COLOR DEVELOPERS, COLOR INTEN-  
SIFIERS, AND HAIR CONDITIONERS, in CLASS 51.  
First use Feb. 22, 1921; in commerce Feb. 22, 1921.  
Owner of U. S. Reg. Nos. 540,541 and 564,689.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736  
Published in the Official Gazette on May 6, 2008  
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC.,

Opposer,

v.

ROBERT VICTOR MARCON,

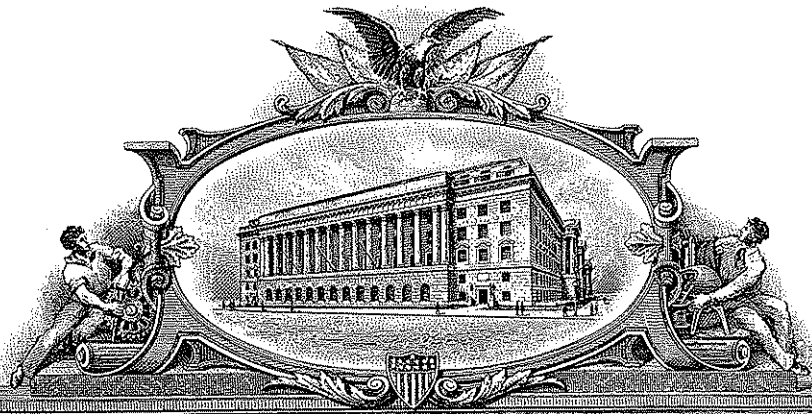
Applicant.

Opposition No. 91184456

**ORAL ARGUMENT REQUESTED**

**EXHIBIT E-3 TO OPPOSER'S NOTICE OF RELIANCE**

7239006



# THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

May 17, 2010

THE ATTACHED U.S. TRADEMARK REGISTRATION 3,109,618 IS  
CERTIFIED TO BE A TRUE COPY OF THE REGISTRATION ISSUED BY  
THE UNITED STATES PATENT AND TRADEMARK OFFICE WHICH  
REGISTRATION IS IN FULL FORCE AND EFFECT.

REGISTERED FOR A TERM OF 10 YEARS FROM June 27, 2006  
SAID RECORDS SHOW TITLE TO BE IN: *Registrant*

By Authority of the  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office

T. LAWRENCE  
Certifying Officer





**Int. Cl.: 3**

**Prior U.S. Cls.: 1, 4, 6, 50, 51, and 52**

**Reg. No. 3,109,618**

**United States Patent and Trademark Office**

**Registered June 27, 2006**

**TRADEMARK  
PRINCIPAL REGISTER**

**L'OREAL ENDLESS**

L'OREAL (FRANCE SOCIETE ANONYME)  
14, RUE ROYALE  
75008 PARIS, FRANCE

FIRST USE 12-0-2001; IN COMMERCE 12-0-2001.

SN 76-325,893, FILED 10-16-2001.

FOR: LIPSTICK, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51  
AND 52).

CHRIS WELLS, EXAMINING ATTORNEY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736  
Published in the Official Gazette on May 6, 2008  
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC.,

Opposer,

v.

ROBERT VICTOR MARCON,

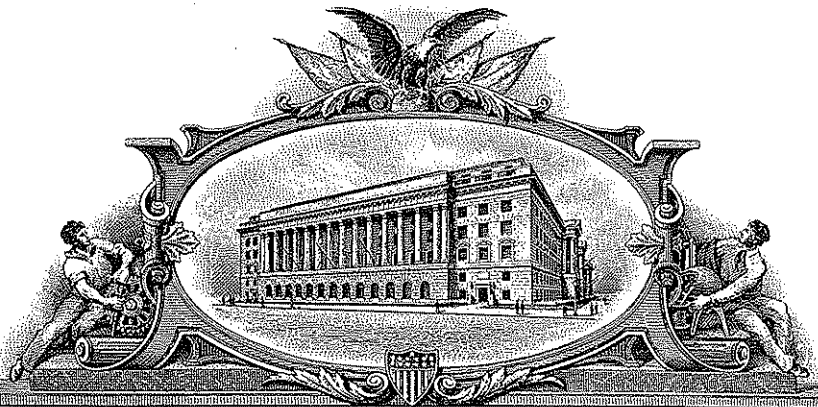
Applicant.

Opposition No. 91184456

**ORAL ARGUMENT REQUESTED**

**EXHIBIT E-4 TO OPPOSER'S NOTICE OF RELIANCE**

7239006



# THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

May 17, 2010

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CERTIFIED TO BE A TRUE COPY OF THE REGISTRATION ISSUED BY  
THE UNITED STATES PATENT AND TRADEMARK OFFICE WHICH  
REGISTRATION IS IN FULL FORCE AND EFFECT.

REGISTERED FOR A TERM OF 10 YEARS FROM July 18, 2006  
SAID RECORDS SHOW TITLE TO BE IN: *Registrant*

By Authority of the  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office

T. LAWRENCE  
Certifying Officer



Int. Cls.: 35 and 41

Prior U.S. Cls.: 100, 101, 102 and 107

United States Patent and Trademark Office

Reg. No. 3,115,751

Registered July 18, 2006

**SERVICE MARK  
PRINCIPAL REGISTER**

**L'OREAL E-STRAT CHALLENGE**

L'OREAL (FRANCE SOCIETE ANONYME)  
14, RUE ROYALE  
PARIS, FRANCE 75008

FOR: ADVERTISING AND ADVERTISEMENT  
SERVICES FOR OTHERS THROUGH PRINTED  
MEDIA, INTRANET, AND INTERNET, IN CLASS  
35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 12-20-2004; IN COMMERCE 12-20-2004.

FOR: EDUCATION SERVICES, NAMELY PRO-  
VIDING UNIVERSITY LEVEL TRAINING COUR-  
SES AND ORGANIZING ACADEMIC  
COMPETITIONS IN THE FIELDS OF MARKETING,  
BUSINESS, AND ECONOMICS, IN CLASS 41 (U.S.  
CLS. 100, 101 AND 107).

FIRST USE 12-31-2000; IN COMMERCE 12-31-2000.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 540,541, 6,617,46 AND  
OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "CHALLENGE", APART FROM  
THE MARK AS SHOWN.

SER. NO. 76-625,268, FILED 12-20-2004.

JOHN WILKE, EXAMINING ATTORNEY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736  
Published in the Official Gazette on May 6, 2008  
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC.,

Opposer,

v.

ROBERT VICTOR MARCON,

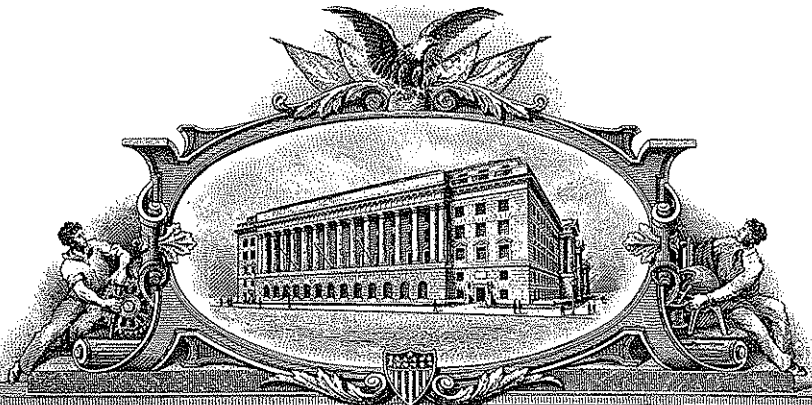
Applicant.

Opposition No. 91184456

**ORAL ARGUMENT REQUESTED**

**EXHIBIT E-5 TO OPPOSER'S NOTICE OF RELIANCE**

7239006



# THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

May 17, 2010

THE ATTACHED U.S. TRADEMARK REGISTRATION 3,081,932 IS  
CERTIFIED TO BE A TRUE COPY OF THE REGISTRATION ISSUED BY  
THE UNITED STATES PATENT AND TRADEMARK OFFICE WHICH  
REGISTRATION IS IN FULL FORCE AND EFFECT.

REGISTERED FOR A TERM OF 10 YEARS FROM *April 18, 2006*  
SAID RECORDS SHOW TITLE TO BE IN: *Registrant*

By Authority of the  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office

T. LAWRENCE  
Certifying Officer



Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

**United States Patent and Trademark Office**

**Reg. No. 3,081,932**

Registered Apr. 18, 2006

**SERVICE MARK  
PRINCIPAL REGISTER**

**L'OREAL  
PROFESSIONNEL  
ELITE**

L'OREAL (FRANCE SOCIETE ANONYME)  
14, RUE ROYALE  
PARIS, FRANCE 75008

FOR: CONDUCTING A LOYALTY INCENTIVE  
REWARD PROGRAM FOR INDEPENDENT BEAU-  
TY SALONS WHEREBY PARTICIPATING MEMBER  
SALONS CAN REDEEM EARNED POINTS FOR  
SELECTED REWARDS, IN CLASS 35 (U.S. CLS. 100,  
101 AND 102).

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

OWNER OF FRANCE REG. NO. 01/3117800, DA-  
TED 8-23-2001, EXPIRES 8-23-2011.

OWNER OF U.S. REG. NOS. 540,541, 6,617,46 AND  
OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "PROFESSIONNEL", APART FROM  
THE MARK AS SHOWN.

THE FOREIGN WORDING IN THE MARK  
TRANSLATES INTO ENGLISH AS PROFESSIONAL.

SER. NO. 78-498,989, FILED 10-13-2004.

JOHN WILKE, EXAMINING ATTORNEY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736  
Published in the Official Gazette on May 6, 2008  
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC.,

Opposer,

v.

ROBERT VICTOR MARCON,

Applicant.

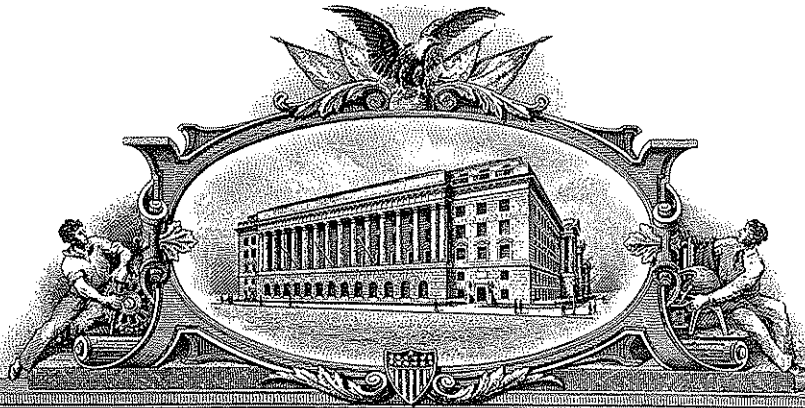
Opposition No. 91184456

**ORAL ARGUMENT REQUESTED**

**EXHIBIT E-6 TO OPPOSER'S NOTICE OF RELIANCE**



7239006



# THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

May 17, 2010

THE ATTACHED U.S. TRADEMARK REGISTRATION 3,281,234 IS  
CERTIFIED TO BE A TRUE COPY OF THE REGISTRATION ISSUED BY  
THE UNITED STATES PATENT AND TRADEMARK OFFICE WHICH  
REGISTRATION IS IN FULL FORCE AND EFFECT.

REGISTERED FOR A TERM OF 10 YEARS FROM *August 21, 2007*  
SAID RECORDS SHOW TITLE TO BE IN: *Registrant*

By Authority of the  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office

T. LAWRENCE  
Certifying Officer



Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51 and 52

United States Patent and Trademark Office

Reg. No. 3,281,234

Registered Aug. 21, 2007

TRADEMARK  
PRINCIPAL REGISTER

# L'OREAL TECHNIQUE

L'OREAL (FRANCE SOCIETE ANONYME)

14, RUE ROYALE

PARIS, FRANCE 75008

FOR: SHAMPOOS; GELS, SPRAYS, MOUSSES  
AND BALMS FOR HAIR STYLING AND HAIR  
CARE; HAIR LACQUERS; HAIR COLOURING  
AND HAIR DECOLORANT PREPARATIONS; PER-  
MANENT WAVING AND CURLING PREPARA-  
TIONS; ESSENTIAL OILS FOR PERSONAL USE, IN  
CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

PRIORITY CLAIMED UNDER SEC. 44(D) ON  
FRANCE APPLICATION NO. 043280122, FILED 3-  
16-2004, REG. NO. 043280122, DATED 3-16-2004, EX-  
PIRES 3-16-2014.

OWNER OF U.S. REG. NO. 540,541.

SER. NO. 76-608,927, FILED 8-27-2004.

HELEN BRYAN, EXAMINING ATTORNEY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736  
Published in the Official Gazette on May 6, 2008  
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC.,

Opposer,

v.

ROBERT VICTOR MARCON,

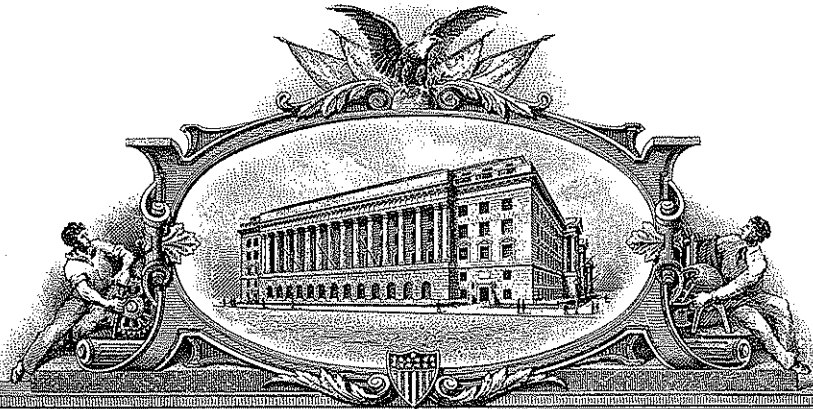
Applicant.

Opposition No. 91184456

**ORAL ARGUMENT REQUESTED**

**EXHIBIT E-7 TO OPPOSER'S NOTICE OF RELIANCE**

7239006



# THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

May 14, 2010

THE ATTACHED U.S. TRADEMARK REGISTRATION 3,453,735 IS  
CERTIFIED TO BE A TRUE COPY OF THE REGISTRATION ISSUED BY  
THE UNITED STATES PATENT AND TRADEMARK OFFICE WHICH  
REGISTRATION IS IN FULL FORCE AND EFFECT.

REGISTERED FOR A TERM OF 10 YEARS FROM *June 24, 2008*  
SAID RECORDS SHOW TITLE TO BE IN: *Registrant*

By Authority of the  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office

M. K. CARTER  
Certifying Officer



**Int. Cl.: 3**

**Prior U.S. Cls.: 1, 4, 6, 50, 51 and 52**

**United States Patent and Trademark Office**

**Reg. No. 3,453,735**

**Registered June 24, 2008**

**TRADEMARK  
PRINCIPAL REGISTER**

**L'OREAL INFINIUM**

L'OREAL (FRANCE SOCIETE ANONYME)  
14, RUE ROYALE  
PARIS, FRANCE 75008

OWNER OF FRANCE REG. NO. 97708935, DATED  
12-15-1997, EXPIRES 12-15-2008.

FOR: HAIR SPRAY, IN CLASS 3 (U.S. CLS. 1, 4, 6,  
50, 51 AND 52).

OWNER OF U.S. REG. NOS. 661,746 AND 1,426,174.

FIRST USE 10-1-2006; IN COMMERCE 10-1-2006.

SER. NO. 78-685,333, FILED 8-4-2005.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

ALLISON SCHRODY, EXAMINING ATTORNEY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736  
Published in the Official Gazette on May 6, 2008  
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC.,

Opposer,

v.

ROBERT VICTOR MARCON,

Applicant.

Opposition No. 91184456

**ORAL ARGUMENT REQUESTED**

**EXHIBIT F-1 TO OPPOSER'S NOTICE OF RELIANCE**

# Research Report

THOMSON COMPUMARK

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## File History

SN: 77/354359

Mark: L'OREAL OUR WORLD

Client Name: PAUL HASTINGS ET AL

Attention: EDITH LOPEZ

Our File: 1709790

Date Completed: May 12, 2010

## Washington Document Services

If we may be of any further assistance, or if you have any questions regarding this report, please do not hesitate to contact us at 1-800-356-8630.

Acceptance and reliance upon this report by the client constitutes an acceptance of its terms, conditions and limitations. Any liability arising out of the preparation of this report is limited to a refund of the search fee paid.

We have taken all reasonable steps to ensure the completeness and accuracy of this report; however, due to the highly subjective nature of copyright and title searching we cannot otherwise guarantee these results. This search is valid only for the property or title noted above. If the property or title which was the subject of this search is changed, even slightly, a new search should be conducted. Please note that this report in no way constitutes a legal opinion.



## Trademark/Service Mark Application, Principal Register

Serial Number: 77354359

Filing Date: 12/18/2007

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	77354359
<b>MARK INFORMATION</b>	
*MARK	<u>L'OREAL OUR WORLD</u>
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	L'OREAL OUR WORLD
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
<b>REGISTER</b>	Principal
<b>APPLICANT INFORMATION</b>	
*OWNER OF MARK	L'Oreal
*STREET	14 rue Royale
*CITY	Paris
*COUNTRY	France
*ZIP/POSTAL CODE (Required for U.S. applicants only)	75008
<b>LEGAL ENTITY INFORMATION</b>	
TYPE	SOCIÉTÉ ANONYME (SA)
STATE/COUNTRY WHERE LEGALLY ORGANIZED	France
<b>GOODS AND/OR SERVICES AND BASIS INFORMATION</b>	
*INTERNATIONAL CLASS	003



<b>*IDENTIFICATION</b>	Line of kid's shampoos and conditioners
<b>FILING BASIS</b>	<b>SECTION 1(b)</b>
<b>ATTORNEY INFORMATION</b>	
<b>NAME</b>	Robert L. Sherman
<b>ATTORNEY DOCKET NUMBER</b>	29172.00012
<b>FIRM NAME</b>	Paul, Hastings, Janofsky & Walker LLP
<b>STREET</b>	75 East 55th Street
<b>CITY</b>	New York
<b>STATE</b>	New York
<b>COUNTRY</b>	United States
<b>ZIP/POSTAL CODE</b>	10022
<b>PHONE</b>	212-318-6037
<b>FAX</b>	212-318-6847
<b>EMAIL ADDRESS</b>	rls@paulhastings.com
<b>AUTHORIZED TO COMMUNICATE VIA EMAIL</b>	Yes
<b>OTHER APPOINTED ATTORNEY</b>	Margarita Wallach, Sara Crisafulli, Bradford Young, Lisa Willis and Natalie Furman
<b>DOMESTIC REPRESENTATIVE INFORMATION</b>	
<b>NAME</b>	Robert L. Sherman
<b>FIRM NAME</b>	Paul, Hastings, Janofsky & Walker LLP
<b>STREET</b>	75 East 55th Street
<b>CITY</b>	New York
<b>STATE</b>	New York
<b>COUNTRY</b>	United States
<b>ZIP CODE</b>	10022
<b>PHONE</b>	212-318-6037
<b>FAX</b>	212-318-6847
<b>EMAIL ADDRESS</b>	rls@paulhastings.com
<b>AUTHORIZED TO COMMUNICATE VIA EMAIL</b>	Yes

<b>CORRESPONDENCE INFORMATION</b>	
NAME	Robert L. Sherman
FIRM NAME	Paul, Hastings, Janofsky & Walker LLP
STREET	75 East 55th Street
CITY	New York
STATE	New York
COUNTRY	United States
ZIP/POSTAL CODE	10022
PHONE	212-318-6037
FAX	212-318-6847
EMAIL ADDRESS	rls@paulhastings.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
<b>FEE INFORMATION</b>	
NUMBER OF CLASSES	1
FEE PER CLASS	325
*TOTAL FEE DUE	325
*TOTAL FEE PAID	325
<b>SIGNATURE INFORMATION</b>	
SIGNATURE	/José Monteiro/
SIGNATORY'S NAME	José MONTEIRO
SIGNATORY'S POSITION	Chief Trademark Counsel
DATE SIGNED	12/18/2007

**Trademark/Service Mark Application, Principal Register**

**Serial Number: 77354359**

**Filing Date: 12/18/2007**

**To the Commissioner for Trademarks:**

**MARK:** L'OREAL OUR WORLD (Standard Characters, see mark)

The literal element of the mark consists of L'OREAL OUR WORLD.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, L'Oreal, a SOCIÉTÉ ANONYME (SA) legally organized under the laws of France, having an address of

14 rue Royale

Paris 75008

France

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended.

International Class 003: Line of kid's shampoos and conditioners

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

The applicant hereby appoints Robert L. Sherman and Margarita Wallach, Sara Crisafulli, Bradford Young, Lisa Willis and Natalie Furman of Paul, Hastings, Janofsky & Walker LLP

75 East 55th Street

New York, New York 10022

United States

to submit this application on behalf of the applicant. The attorney docket/reference number is 29172.00012.

The applicant hereby appoints Robert L. Sherman of Paul, Hastings, Janofsky & Walker LLP

75 East 55th Street

New York New York 10022

United States

as applicant's representative upon whom notice or process in the proceedings affecting the mark may be served.

Correspondence Information: Robert L. Sherman

75 East 55th Street

New York, New York 10022

212-318-6037(phone)

212-318-6847(fax)

rls@paulhastings.com (authorized)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

### **Declaration**

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /José Monteiro/ Date Signed: 12/18/2007

Signatory's Name: José MONTEIRO

Signatory's Position: Chief Trademark Counsel

RAM Sale Number: 6025

RAM Accounting Date: 12/18/2007

Serial Number: 77354359

Internet Transmission Date: Tue Dec 18 10:22:53 EST 2007

TEAS Stamp: USPTO/BAS-216.241.250.30-200712181022538

24379-77354359-400d77d4f503841de1d9bfd99

ade1b72be6-DA-6025-20071217154539515350

L'OREAL OUR WORLD

L'OREAL OUR WORLD

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**To:** L'Oreal ([rls@paulhastings.com](mailto:rls@paulhastings.com))  
**Subject:** TRADEMARK APPLICATION NO. 77354359 - L'OREAL OUR WORLD  
- 29172.00012  
**Sent:** 3/15/2008 8:25:01 PM  
**Sent As:** ECOM106@USPTO.GOV  
**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)  
[Attachment - 3](#)  
[Attachment - 4](#)  
[Attachment - 5](#)  
[Attachment - 6](#)  
[Attachment - 7](#)

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77/354359

**MARK:** L'OREAL OUR WORLD

**\*77354359\***

**CORRESPONDENT ADDRESS:**

ROBERT L. SHERMAN  
PAUL, HASTINGS, JANOFKY & WALKER  
LLP  
75 E 55TH ST  
NEW YORK, NY 10022-3404

**RESPOND TO THIS ACTION:**

<http://www.uspto.gov/teas/eTEASpageD.htm>

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** L'Oreal

**CORRESPONDENT'S REFERENCE/DOCKET**

**NO:**

29172.00012

**CORRESPONDENT E-MAIL ADDRESS:**

[rls@paulhastings.com](mailto:rls@paulhastings.com)

**OFFICE ACTION**

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

**ISSUE/MAILING DATE:** 3/15/2008

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

The assigned examining attorney has reviewed the referenced application and determined the following.

### **Ownership of Prior Registrations**

If applicant is the owner of U.S. Registration Nos. 0540541, 0661746, 3081932 and others, then applicant must submit a claim of ownership. 37 C.F.R. §2.36; TMEP §812. See attached registrations. The following standard format is suggested:

Applicant is the owner of U.S. Registration Nos. 0540541, 0661746, 3081932 and others.

### **Indefinite Identification of Goods**

The identification of goods is unacceptable because the precise nature of the goods is unclear. The applicant must amend the identification to specify the common commercial names of the goods. If there is no common commercial name, the applicant must describe the product and its intended uses or purpose. TMEP §1402.11; §1402.01.

The applicant may adopt the following identification, if accurate:

Line of kid's shampoos and hair conditioners, in class 003

**If the above suggestions are not accurate, the examining attorney *highly* recommends that the applicant consult the online Trademark Acceptable Identification of Goods and Services Manual to ensure that any amendments made to the identification of goods comport with Office requirements. While the list is not exhaustive, the manual should give the applicant direction regarding proper international classification and information regarding the specificity required in the applicant's identification of goods. Go to: <http://tess2.uspto.gov/netahtml/tidm.html>.**

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend to include any goods that are not within the scope of goods set forth in the present identification.

### **Telephone or Email Response Suggested**

PLEASE NOTE: All of the issues raised can be resolved by telephone. The applicant may telephone the examining attorney, instead of submitting a written response, to expedite the application. (In lieu of calling, applicant may resolve the outstanding issues raised in this Office Action by submitting an email to [david.elton@uspto.gov](mailto:david.elton@uspto.gov) indicating agreement with the examining attorney's suggested amendments. Please include the Serial No. of the application when responding by email.)



/David Elton/  
Examining Attorney  
Law Office 106  
Tel: 571-272-9317  
Fax: 571-273-9106  
email: david.elton@uspto.gov

**RESPOND TO THIS ACTION:** If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office action should be filed using the form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

**Print: Mar 15, 2008**

**71597300**

**DESIGN MARK**

**Serial Number**

71597300

**Status**

REGISTERED AND RENEWED

**Word Mark**

L'OREAL

**Standard Character Mark**

No

**Registration Number**

0540541

**Date Registered**

1951/04/03

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

**Owner**

L'OREAL CORPORATION FRANCE 14, RUE ROYALE PARIS CEDEX FRANCE 75008

**Goods/Services**

Class Status -- ACTIVE. IC 003. US 051. G & S: ROUGE, FACE CREAM, HAIR LOTION, HAND CREAM, EYE SHADOW, FACE LOTION, PERFUME, COLOGNE, NAIL POLISH, SUNTAN OIL AND FACE POWDER.

**Foreign Country Name**

FRANCE

**Foreign Registration Number**

375704

**Foreign Registration Date**

1947/03/13

**Filing Date**

1950/05/11

**Examining Attorney**

UNKNOWN

**Print: Mar 15, 2008**

**71597300**

**Attorney of Record**

THOMAS S. BAKER JR.

**L'ORÉAL**

**Print: Mar 15, 2008**

**72010934**

**TYPED DRAWING**

**Serial Number**

72010934

**Status**

REGISTERED AND RENEWED

**Word Mark**

L'OREAL

**Standard Character Mark**

No

**Registration Number**

0661746

**Date Registered**

1958/05/13

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(1) TYPED DRAWING

**Owner**

L'OREAL SOCIETE ANONYME FRANCE 14, RUE ROYALE PARIS FRANCE 75008

**Goods/Services**

Class Status -- ACTIVE. IC 003. US 051. G & S: HAIR COLORINGS, COLOR RINSES, HAIR BLEACHES, COLOR DEVELOPERS, COLOR INTENSIFIERS, AND HAIR CONDITIONERS. First Use: 1921/02/22. First Use In Commerce: 1921/02/22.

**Prior Registration(s)**

0540541;0564689

**Filing Date**

1956/06/25

**Examining Attorney**

UNKNOWN

**Attorney of Record**

Robert L. Sherman

**Print: Mar 15, 2008**

**78498989**

**DESIGN MARK**

**Serial Number**

78498989

**Status**

REGISTERED

**Word Mark**

L'OREAL PROFESSIONNEL ELITE

**Standard Character Mark**

Yes

**Registration Number**

3081932

**Date Registered**

2006/04/18

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

L'Oreal SOCIETE ANONYME FRANCE 14, rue Royale Paris FRANCE 75008

**Goods/Services**

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Conducting a loyalty incentive reward program for independent beauty salons whereby participating member salons can redeem earned points for selected rewards.

**Foreign Country Name**

FRANCE

**Foreign Registration Number**

01/3117800

**Foreign Registration Date**

2001/08/23

**Foreign Expiration Date**

2011/08/23

**Prior Registration(s)**

**Print: Mar 15, 2008**

**78498989**

0540541;0661746;2200948;540541 ;661746 ;AND OTHERS

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "professionnel" APART FROM THE MARK AS SHOWN.

**Translation Statement**

The foreign wording in the mark translates into English as professional.

**Filing Date**

2004/10/13

**Examining Attorney**

WILKE, JOHN

**Attorney of Record**

Robert L. Sherman

L'OREAL  
PROFESSIONNEL  
ELITE



---

**To:** L'Oreal ([rls@paulhastings.com](mailto:rls@paulhastings.com))  
**Subject:** TRADEMARK APPLICATION NO. 77354359 - L'OREAL OUR WORLD  
- 29172.00012  
**Sent:** 3/15/2008 8:25:04 PM  
**Sent As:** ECOM106@USPTO.GOV  
**Attachments:**

---

**IMPORTANT NOTICE**  
**USPTO OFFICE ACTION HAS ISSUED ON 3/15/2008 FOR**  
**APPLICATION SERIAL NO. 77354359**

Please follow the instructions below to continue the prosecution of your application:

**VIEW OFFICE ACTION:** Click on this link  
[http://tmpportal.uspto.gov/external/portal/tow?DDA=Y&serial\\_number=77354359&doc\\_type=OOA&](http://tmpportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77354359&doc_type=OOA&)  
(or copy and paste this URL into the address field of your browser), or visit  
<http://tmpportal.uspto.gov/external/portal/tow> and enter the application serial number to access the  
Office action.

**PLEASE NOTE:** The Office action may not be immediately available but will be viewable within 24 hours of this notification.

**RESPONSE MAY BE REQUIRED:** You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable response time period. Your response deadline will be calculated from 3/15/2008.

**Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.**

**HELP:** For *technical* assistance in accessing the Office action, please e-mail [TDR@uspto.gov](mailto:TDR@uspto.gov). Please contact the assigned examining attorney with questions about the Office action.

**WARNING**

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the**

**ABANDONMENT of your application.**

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	77354359
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 106
<b>MARK SECTION (no change)</b>	
<b>GOODS AND/OR SERVICES SECTION (current)</b>	
INTERNATIONAL CLASS	003
DESCRIPTION	Line of kid's shampoos and conditioners
FILING BASIS	Section 1(b)
<b>GOODS AND/OR SERVICES SECTION (proposed)</b>	
INTERNATIONAL CLASS	003
DESCRIPTION	Hair shampoos and conditioners
FILING BASIS	Section 1(b)
<b>ADDITIONAL STATEMENTS SECTION</b>	
PRIOR REGISTRATION(S)	Applicant claims ownership of U.S. Registration Number(s) 0540541, 0661746, 3081932 and others.
<b>SIGNATURE SECTION</b>	
DECLARATION SIGNATURE	The filing Attorney has elected not to submit the signed declaration, believing no supporting declaration is required under the <i>Trademark Rules of Practice</i> .
RESPONSE SIGNATURE	/bey/
SIGNATORY'S NAME	Bradford E. Young
SIGNATORY'S POSITION	Attorney for Applicant
DATE SIGNED	09/12/2008
AUTHORIZED SIGNATORY	YES
<b>FILING INFORMATION SECTION</b>	

**SUBMIT DATE**

Fri Sep 12 15:28:50 EDT 2008

**TEAS STAMP**

USPTO/ROA-216.241.250.30-  
20080912152850999382-7735  
4359-430fd26b06ebd9e1bbf3  
c5247765f6edb-N/A-N/A-200  
80912152443256030

## **Response to Office Action**

### **To the Commissioner for Trademarks:**

Application serial no. **77354359** has been amended as follows:

#### **CLASSIFICATION AND LISTING OF GOODS/SERVICES**

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 003 for Line of kid's shampoos and conditioners

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use:** The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

**Proposed:** Class 003 for Hair shampoos and conditioners

**Filing Basis: Section 1(b), Intent to Use:** The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

#### **ADDITIONAL STATEMENTS**

##### **Claim of Prior Registration(s)**

Applicant claims ownership of U.S. Registration Number(s) 0540541, 0661746, 3081932 and others.

#### **SIGNATURE(S)**

##### **Declaration Signature**

I hereby elect to bypass the submission of a signed declaration, because I believe a declaration is not required by the rules of practice. I understand that the examining attorney could still, upon later review, require a signed declaration.

##### **Response Signature**

Signature: /bey/ Date: 09/12/2008

Signatory's Name: Bradford E. Young

Signatory's Position: Attorney for Applicant

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 77354359

Internet Transmission Date: Fri Sep 12 15:28:50 EDT 2008

TEAS Stamp: USPTO/ROA-216.241.250.30-200809121528509

99382-77354359-430fd26b06ebd9e1bbf3c5247

765f6edb-N/A-N/A-20080912152443256030

---

**To:** L'Oreal ([rls@paulhastings.com](mailto:rls@paulhastings.com))  
**Subject:** TRADEMARK APPLICATION NO. 77354359 - L'OREAL OUR WORLD  
- 29172.00012  
**Sent:** 10/10/2008 9:34:11 PM  
**Sent As:** ECOM106@USPTO.GOV  
**Attachments:**

---

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77/354359

**MARK:** L'OREAL OUR WORLD

**\*77354359\***

**CORRESPONDENT ADDRESS:**

ROBERT L. SHERMAN  
PAUL, HASTINGS, JANOFSKY & WALKER  
LLP  
75 E 55TH ST  
NEW YORK, NY 10022-3404

**RESPOND TO THIS ACTION:**

<http://www.uspto.gov/teas/eTEASpageD.htm>

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** L'Oreal

**CORRESPONDENT'S REFERENCE/DOCKET**

**NO:** 29172.00012

**CORRESPONDENT E-MAIL ADDRESS:**

[rls@paulhastings.com](mailto:rls@paulhastings.com)

**OFFICE ACTION**

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

**ISSUE/MAILING DATE:** 10/10/2008

**THIS IS A FINAL ACTION.**

This Office action is in response to applicant's communication filed on 9/12/08. Applicant's claim of ownership of prior registrations is acceptable. The requirement to amend the identification of goods is now made final.

## IDENTIFICATION OF GOODS – FINAL REQUIREMENT

The original identification of goods remains indefinite and must be clarified. *See* TMEP §1402.01. Moreover, the proposed amendment to the identification cannot be accepted because it refers to goods that are not within the scope of the identification that was set forth in the application at the time of filing. *See* 37 C.F.R. §2.71(a).

The amendment identifies the following goods: ‘Hair shampoos and conditioners.’ This wording is beyond the scope of the original identification. The original identification included the word “kid’s,” thus limiting the goods to those intended for children. Omission of the word “kid’s” constitutes an unacceptable broadening of the scope of the original identification.

Identifications can be amended only to clarify or limit the goods and/or services; adding to or broadening the scope of the goods and/or services is not permitted. *Id.*; *see* TMEP §§1402.06 *et seq.*, 1402.07. Therefore, the word “kid’s,” or a synonym thereof, must remain in the identification.

Applicant may adopt the following identification:

Hair shampoos and conditioners for children, in class 003

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahtml/tidm.html>. *See* TMEP §1402.04.

Applicant is encouraged to telephone the assigned trademark examining attorney to resolve the issues raised in this Office action.

If applicant does not respond within six months of the mailing date of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

/David Elton/  
Examining Attorney  
Law Office 106  
Tel: 571-272-9317  
Fax: 571-273-9106  
email: david.elton@uspto.gov

**RESPOND TO THIS ACTION:** Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.



---

**To:** L'Oreal ([rls@paulhastings.com](mailto:rls@paulhastings.com))  
**Subject:** TRADEMARK APPLICATION NO. 77354359 - L'OREAL OUR WORLD  
- 29172.00012  
**Sent:** 10/10/2008 9:34:14 PM  
**Sent As:** ECOM106@USPTO.GOV  
**Attachments:**

---

**IMPORTANT NOTICE**  
**USPTO OFFICE ACTION HAS ISSUED ON 10/10/2008 FOR**  
**APPLICATION SERIAL NO. 77354359**

Please follow the instructions below to continue the prosecution of your application:

**VIEW OFFICE ACTION:** Click on this link  
[http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial\\_number=77354359&doc\\_type=OOA&](http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77354359&doc_type=OOA&)  
(or copy and paste this URL into the address field of your browser), or visit  
<http://tmportal.uspto.gov/external/portal/tow> and enter the application serial number to access the  
Office action.

**PLEASE NOTE:** The Office action may not be immediately available but will be viewable within 24 hours of this notification.

**RESPONSE MAY BE REQUIRED:** You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable response time period. Your response deadline will be calculated from 10/10/2008.

**Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.**

**HELP:** For *technical* assistance in accessing the Office action, please e-mail [TDR@uspto.gov](mailto:TDR@uspto.gov). Please contact the assigned examining attorney with questions about the Office action.

**WARNING**

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the**

**ABANDONMENT of your application.**

---

**To:** L'Oreal ([rls@paulhastings.com](mailto:rls@paulhastings.com))  
**Subject:** TRADEMARK APPLICATION NO. 77354359 - L'OREAL OUR WORLD  
- 29172.00012  
**Sent:** 3/26/2009 6:41:53 PM  
**Sent As:** ECOM106@USPTO.GOV  
**Attachments:**

---

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77/354359

**MARK:** L'OREAL OUR WORLD

**\*77354359\***

**CORRESPONDENT ADDRESS:**

ROBERT L. SHERMAN  
PAUL, HASTINGS, JANOFSKY &  
WALKER LLP  
75 E 55TH ST  
NEW YORK, NY 10022-3404

**GENERAL TRADEMARK INFORMATION:**  
<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** L'Oreal

**CORRESPONDENT'S REFERENCE/DOCKET**

**NO:** 29172.00012

**CORRESPONDENT E-MAIL ADDRESS:**

[rls@paulhastings.com](mailto:rls@paulhastings.com)

**EXAMINER'S AMENDMENT**

**ISSUE/MAILING DATE:** 3/26/2009

**AMENDMENT:** In accordance with the authorization granted by Brad Young on 3/26/09, the application has been AMENDED as indicated below. Please advise the undersigned examining attorney immediately if there is an objection to the amendment. Otherwise, no response is necessary. TMEP §707.

If the identification of goods and/or services has been amended, please note that any future amendments must be in accordance with 37 C.F.R. §2.71(a) and TMEP §1402.07(e).

Applicant adopts the following identification:

Hair shampoos and conditioners for children, in class 003

/David Elton/  
Examining Attorney  
Law Office 106  
Tel: 571-272-9317  
Fax: 571-273-9106  
email: david.elton@uspto.gov

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

---

**To:** L'Oreal ( [rls@paulhastings.com](mailto:rls@paulhastings.com) )  
**Subject:** TRADEMARK APPLICATION NO. 77354359 - L'OREAL OUR WORLD  
- 29172.00012  
**Sent:** 3/26/2009 6:41:56 PM  
**Sent As:** ECOM106@USPTO.GOV  
**Attachments:**

---

**IMPORTANT NOTICE**  
**USPTO OFFICE ACTION HAS ISSUED ON 3/26/2009 FOR**  
**APPLICATION SERIAL NO. 77354359**

Please follow the instructions below to continue the prosecution of your application:

**VIEW OFFICE ACTION:** Click on this link  
[http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial\\_number=77354359&doc\\_type=EXA&1](http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77354359&doc_type=EXA&1)  
(or copy and paste this URL into the address field of your browser), or visit  
<http://tmportal.uspto.gov/external/portal/tow> and enter the application serial number to access the  
Office action.

**PLEASE NOTE:** The Office action may not be immediately available but will be viewable within 24 hours of this notification.

**RESPONSE MAY BE REQUIRED:** You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable response time period. Your response deadline will be calculated from 3/26/2009.

**Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.**

**HELP:** For *technical* assistance in accessing the Office action, please e-mail [TDR@uspto.gov](mailto:TDR@uspto.gov). Please contact the assigned examining attorney with questions about the Office action.

**WARNING**

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the**

**ABANDONMENT of your application.**

UNITED STATES PATENT AND TRADEMARK OFFICE

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Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451  
[www.uspto.gov](http://www.uspto.gov)

Apr 15, 2009

**NOTICE OF PUBLICATION UNDER 12(a)**

- |                                     |  |
|-------------------------------------|--|
| 1. Serial No.:<br>77/354,359        | 2. Mark:<br>L'OREAL OUR WORLD<br>Standard Character Mark |
| 3. International Class(es):<br>3    |  |
| 4. Publication Date:<br>May 5, 2009 | 5. Applicant:<br>L'Oreal                                 |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a notice of allowance pursuant to section 13(b) of the Statute.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents  
U.S. Government Printing Office  
PO Box 371954  
Pittsburgh, PA 15250-7954  
Phone: 202-512-1800

By direction of the Commissioner.

---

Correspondence Address:

ROBERT L. SHERMAN  
PAUL, HASTINGS, JANOFSKY & WALKER LLP  
75 E 55TH ST  
NEW YORK, NY 10022-3404

TMP&I



U.S. Patent and Trademark Office (USPTO)

**NOTICE OF ALLOWANCE**

NOTE: If any data on this notice is incorrect, please fax a request for correction to the Intent to Use Unit at 571-273-9550. Please include the serial number of your application on ALL correspondence with the USPTO.

**ISSUE DATE:** Jul 28, 2009

ROBERT L. SHERMAN  
PAUL, HASTINGS, JANOFSKY & WALKER LLP  
75 E 55TH ST  
NEW YORK, NY 10022-3404

ATTORNEY  
REFERENCE NUMBER

29172.00012

**\*\* IMPORTANT INFORMATION: 6 MONTH DEADLINE \*\***

You filed the trademark application identified below based upon a bona fide intention to use the mark in commerce. You must use the mark in commerce and file a Statement of Use (a.k.a. Allegation of Use) before the USPTO will register the mark. You have six (6) MONTHS from the ISSUE DATE of this Notice of Allowance (NOA) to file either a Statement of Use, or if you are not yet using the mark in commerce, a Request for Extension of Time to File a Statement of Use ("Extension Request"). If you file an extension request, you must continue to file a new request every six months until the Statement of Use is filed. Applicant may file a total of five (5) extension requests. FAILURE TO FILE A REQUIRED DOCUMENT DURING THE APPROPRIATE TIME PERIOD WILL RESULT IN THE ABANDONMENT OF YOUR APPLICATION. Please note that both the "Statement of Use" and "Extension Request" have many legal requirements including fees. Therefore, we encourage use of the USPTO forms, available online at <http://www.uspto.gov/teas/index.html> (under "File a PRE-registration form"), to avoid the possible omission of important information. Please note that the Trademark Electronic Application System (TEAS) provides line-by-line help instructions for completing the Extension Request or Statement of Use forms online. If you do not have access to the Internet, you may call 1-800-786-9199 to request the printed form(s).

**\*\* Registration Subject to Cancellation for Fraudulent Statements \*\***

Ensure that statements made in filings to the USPTO are accurate, as inaccuracies may result in the cancellation of your trademark registration. The lack of a bona fide intention to use the mark with all goods and/or services included in an application or the lack of use on all goods and/or services for which you claimed use could jeopardize the validity of your registration, possibly resulting in its cancellation.

**The following information should be reviewed for accuracy:**

SERIAL NUMBER:

77/354359

MARK: L'OREAL OUR WORLD (STANDARD CHARACTER MARK)  
OWNER: L'Oreal  
14 rue Royale  
Paris , FRANCE 75008

This application has the following bases, but not necessarily for all listed goods/services:

Section 1(a): NO

Section 1(b): YES

Section 44(e): NO

### **GOODS/SERVICES BY INTERNATIONAL CLASS**

003 - Hair shampoos and conditioners for children -- FIRST USE DATE: NONE; -- USE IN COMMERCE DATE: NONE

**ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED**

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**ADDITIONAL INFORMATION MAY BE PRESENT IN THE USPTO RECORDS**

## SOU Extension Request (15 U.S.C. Section 1051(d))

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	77354359
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 106
<b>MARK SECTION</b>	
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>LITERAL ELEMENT</b>	L'OREAL OUR WORLD
<b>OWNER SECTION (no change)</b>	
<b>GOODS AND/OR SERVICES SECTION</b>	
<b>INTERNATIONAL CLASS</b>	003
<b>CURRENT IDENTIFICATION</b>	Hair shampoos and conditioners for children
<b>GOODS OR SERVICES</b>	KEEP ALL LISTED
<b>EXTENSION SECTION</b>	
<b>EXTENSION NUMBER</b>	1
<b>ALLOWANCE MAIL DATE</b>	07/28/2009
<b>STATEMENT OF USE</b>	NO
<b>PAYMENT SECTION</b>	
<b>NUMBER OF CLASSES</b>	1
<b>SUBTOTAL AMOUNT</b>	150
<b>TOTAL AMOUNT</b>	150
<b>SIGNATURE SECTION</b>	
<b>SIGNATURE</b>	/josé monteiro/
<b>SIGNATORY'S NAME</b>	José MONTEIRO

<b>SIGNATORY'S POSITION</b>	Chief Trademark Counsel
<b>DATE SIGNED</b>	01/18/2010
<b>FILING INFORMATION</b>	
<b>SUBMIT DATE</b>	Tue Jan 19 11:59:47 EST 2010
<b>TEAS STAMP</b>	USPTO/ESU-216.241.250.30- 20100119115947478446-7735 4359-4608369565f599daede4 51686d0b0af7969-DA-13473- 20100115152515546685

**SOU Extension Request  
(15 U.S.C. Section 1051(d))**

To the Commissioner for Trademarks:

**MARK:** L'OREAL OUR WORLD  
**SERIAL NUMBER:** 77354359

The applicant, L'Oreal, having an address of  
14 rue Royale  
Paris, 75008  
France

requests a six-month extension of time to file the Statement of Use under 37 C.F.R. Section 2.89 in this application. The Notice of Allowance mailing date was 07/28/2009.

For International Class 003:

Current identification: Hair shampoos and conditioners for children

The applicant has a continued bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with all of the goods and/or services listed in the Notice of Allowance or as subsequently modified for this specific class.

This is the first extension request.

A fee payment in the amount of \$150 will be submitted with the form, representing payment for 1 class.

### **Declaration**

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the form or any resulting registration, declares that he/she is properly authorized to execute this form on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the form is being filed under 15 U.S.C. Section 1126(d) or (e), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /josé monteiro/ Date Signed: 01/18/2010

Signatory's Name: José MONTEIRO

Signatory's Position: Chief Trademark Counsel

RAM Sale Number: 13473

RAM Accounting Date: 01/19/2010

Serial Number: 77354359

Internet Transmission Date: Tue Jan 19 11:59:47 EST 2010

TEAS Stamp: USPTO/ESU-216.241.250.30-201001191159474

78446-77354359-4608369565f599daede451686

d0b0af7969-DA-13473-20100115152515546685

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451  
[www.uspto.gov](http://www.uspto.gov)

**NOTICE OF APPROVAL OF EXTENSION REQUEST**

Jan 21, 2010

TM106

ROBERT L. SHERMAN  
PAUL, HASTINGS, JANOFSKY & WALKER LLP  
75 E 55TH ST  
NEW YORK, NY 10022-3404

ATTORNEY  
REFERENCE NUMBER:

29172.00012

**SERIAL NUMBER:** 77/354359

**MARK:** L'OREAL OUR WORLD

**OWNER:** L'Oreal

**EXTENSION REQUEST NUMBER:** 1      **NOTICE OF ALLOWANCE DATE:** Jul 28, 2009

A Notice of Allowance was issued on Jul 28, 2009 for the trademark application identified above. The FIRST request for Extension of Time to File a Statement of Use has been approved. Applicant must continue to file extension requests every 6 months calculated from the date the Notice of Allowance was issued until a Statement of Use is filed. Please note that a Statement of Use cannot be filed more than 36 months from the issuance date of the Notice of Allowance. For further information please check the USPTO web site at [www.uspto.gov](http://www.uspto.gov) or call the Trademark Assistance Center at 1-800-786-9199.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736  
Published in the Official Gazette on May 6, 2008  
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC.,

Opposer,

v.

ROBERT VICTOR MARCON,

Applicant.

Opposition No. 91184456

**ORAL ARGUMENT REQUESTED**

**EXHIBIT F-2 TO OPPOSER'S NOTICE OF RELIANCE**

# Research Report

THOMSON COMPUMARK  
you can't live more certain.

## File History

SN: 77/477820

Mark: L'OREAL EXTRA VOLUME COLLAGENE

Client Name: PAUL HASTINGS ET AL

Attention: EDITH LOPEZ

Our File: 1709790

Date Completed: May 12, 2010

## Washington Document Services

If we may be of any further assistance, or if you have any questions regarding this report, please do not hesitate to contact us at 1-800-356-8630.

Acceptance and reliance upon this report by the client constitutes an acceptance of its terms, conditions and limitations. Any liability arising out of the preparation of this report is limited to a refund of the search fee paid.

We have taken all reasonable steps to ensure the completeness and accuracy of this report; however, due to the highly subjective nature of copyright and title searching we cannot otherwise guarantee these results. This search is valid only for the property or title noted above. If the property or title which was the subject of this search is changed, even slightly, a new search should be conducted. Please note that this report in no way constitutes a legal opinion.





# Trademark/Service Mark Application, Principal Register

**Serial Number: 77477820**

**Filing Date: 05/19/2008**

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	77477820
<b>MARK INFORMATION</b>	
<b>*MARK</b>	<u>L'OREAL EXTRA VOLUME</u> <u>COLLAGENE</u>
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>LITERAL ELEMENT</b>	L'OREAL EXTRA VOLUME COLLAGENE
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font, style, size, or color.
<b>REGISTER</b>	Principal
<b>APPLICANT INFORMATION</b>	
<b>*OWNER OF MARK</b>	L'Oreal
<b>*STREET</b>	14 rue Royale
<b>*CITY</b>	Paris
<b>*COUNTRY</b>	France
<b>*ZIP/POSTAL CODE</b> (Required for U.S. applicants only)	75008
<b>LEGAL ENTITY INFORMATION</b>	
<b>TYPE</b>	SOCIÉTÉ ANONYME (SA)
<b>STATE/COUNTRY WHERE LEGALLY ORGANIZED</b>	France
<b>GOODS AND/OR SERVICES AND BASIS INFORMATION</b>	

<b>*INTERNATIONAL CLASS</b>	003
<b>*IDENTIFICATION</b>	Mascaras
<b>FILING BASIS</b>	SECTION 1(b)
<b>ATTORNEY INFORMATION</b>	
<b>NAME</b>	Robert L. Sherman
<b>ATTORNEY DOCKET NUMBER</b>	29172.00012
<b>FIRM NAME</b>	Paul, Hastings, Janofsky & Walker LLP
<b>STREET</b>	75 East 55th Street
<b>CITY</b>	New York
<b>STATE</b>	New York
<b>COUNTRY</b>	United States
<b>ZIP/POSTAL CODE</b>	10022
<b>PHONE</b>	212-318-6037
<b>FAX</b>	212-318-6847
<b>EMAIL ADDRESS</b>	rls@paulhastings.com
<b>AUTHORIZED TO COMMUNICATE VIA EMAIL</b>	Yes
<b>OTHER APPOINTED ATTORNEY</b>	Margarita Wallach, Sara Crisafulli, Bradford Young, Lisa Willis and Natalie Furman
<b>DOMESTIC REPRESENTATIVE INFORMATION</b>	
<b>NAME</b>	Robert L. Sherman
<b>FIRM NAME</b>	Paul, Hastings, Janofsky & Walker LLP
<b>STREET</b>	75 East 55th Street
<b>CITY</b>	New York
<b>STATE</b>	New York
<b>COUNTRY</b>	United States
<b>ZIP CODE</b>	10022
<b>PHONE</b>	212-318-6037
<b>FAX</b>	212-318-6847
<b>EMAIL ADDRESS</b>	rls@paulhastings.com

<b>AUTHORIZED TO COMMUNICATE VIA EMAIL</b>	Yes
<b>CORRESPONDENCE INFORMATION</b>	
<b>NAME</b>	Robert L. Sherman
<b>FIRM NAME</b>	Paul, Hastings, Janofsky & Walker LLP
<b>STREET</b>	75 East 55th Street
<b>CITY</b>	New York
<b>STATE</b>	New York
<b>COUNTRY</b>	United States
<b>ZIP/POSTAL CODE</b>	10022
<b>PHONE</b>	212-318-6037
<b>FAX</b>	212-318-6847
<b>EMAIL ADDRESS</b>	rls@paulhastings.com
<b>AUTHORIZED TO COMMUNICATE VIA EMAIL</b>	Yes
<b>FEE INFORMATION</b>	
<b>NUMBER OF CLASSES</b>	1
<b>FEE PER CLASS</b>	325
<b>*TOTAL FEE DUE</b>	325
<b>*TOTAL FEE PAID</b>	325
<b>SIGNATURE INFORMATION</b>	
<b>SIGNATURE</b>	/José Monteiro/
<b>SIGNATORY'S NAME</b>	José MONTEIRO
<b>SIGNATORY'S POSITION</b>	Chief Trademark Counsel
<b>DATE SIGNED</b>	05/19/2008

## **Trademark/Service Mark Application, Principal Register**

**Serial Number: 77477820**

**Filing Date: 05/19/2008**

### **To the Commissioner for Trademarks:**

**MARK:** L'OREAL EXTRA VOLUME COLLAGENE (Standard Characters, see mark)

The literal element of the mark consists of L'OREAL EXTRA VOLUME COLLAGENE.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, L'Oreal, a SOCIÉTÉ ANONYME (SA) legally organized under the laws of France, having an address of

14 rue Royale  
Paris 75008  
France

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended.

International Class 003: Mascaras

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

The applicant hereby appoints Robert L. Sherman and Margarita Wallach, Sara Crisafulli, Bradford Young, Lisa Willis and Natalie Furman of Paul, Hastings, Janofsky & Walker LLP

75 East 55th Street  
New York, New York 10022  
United States

to submit this application on behalf of the applicant. The attorney docket/reference number is 29172.00012.

The applicant hereby appoints Robert L. Sherman of Paul, Hastings, Janofsky & Walker LLP

75 East 55th Street  
New York New York 10022  
United States

as applicant's representative upon whom notice or process in the proceedings affecting the mark may be served.

Correspondence Information: Robert L. Sherman

75 East 55th Street  
New York, New York 10022  
212-318-6037(phone)  
212-318-6847(fax)

rls@paulhastings.com (authorized)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

### **Declaration**

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /José Monteiro/ Date Signed: 05/19/2008

Signatory's Name: José MONTEIRO

Signatory's Position: Chief Trademark Counsel

RAM Sale Number: 6795

RAM Accounting Date: 05/19/2008

Serial Number: 77477820

Internet Transmission Date: Mon May 19 12:36:04 EDT 2008

TEAS Stamp: USPTO/BAS-216.241.250.30-200805191236040

93266-77477820-40064c34956034333f4d43eac

15f2268d-DA-6795-20080516112155602724

**L'OREAL EXTRA VOLUME  
COLLAGENE**

**L'OREAL EXTRA VOLUME  
COLLAGENE**

---

**To:** L'Oreal ([rls@paulhastings.com](mailto:rls@paulhastings.com))  
**Subject:** TRADEMARK APPLICATION NO. 77477820 - L'OREAL EXTRA  
VOLUME - 29172.00012  
**Sent:** 9/3/2008 4:01:03 PM  
**Sent As:** ECOM108@USPTO.GOV  
**Attachments:** [Attachment - 1](#)  
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[Attachment - 9](#)  
[Attachment - 10](#)  
[Attachment - 11](#)  
[Attachment - 12](#)

---

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77/477820

**MARK:** L'OREAL EXTRA VOLUME

**\*77477820\***

**CORRESPONDENT ADDRESS:**

ROBERT L. SHERMAN  
PAUL, HASTINGS, JANOFSKY & WALKER  
LLP  
75 E 55TH ST  
NEW YORK, NY 10022-3404

**RESPOND TO THIS ACTION:**

<http://www.uspto.gov/teas/eTEASpageD.htm>

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** L'Oreal

**CORRESPONDENT'S REFERENCE/DOCKET**

**NO:**  
29172.00012

**CORRESPONDENT E-MAIL ADDRESS:**

[rls@paulhastings.com](mailto:rls@paulhastings.com)



## **OFFICE ACTION**

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

**ISSUE/MAILING DATE: 9/3/2008**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

### **SEARCH OF OFFICE'S DATABASE OF MARKS**

The Office records have been searched and there are no similar registered or pending marks that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

**However, before the application can proceed, applicant must satisfy the following requirements:**

### **TRANSLATION OF FOREIGN WORDING REQUIRED**

Applicant must submit an English translation of all foreign wording in the mark. TMEP §809; *see* 37 C.F.R. §§2.32(a), 2.61(b). In the present case, the wording "COLLAGENE" requires translation. Please see the attached French/English dictionary evidence, indicating that "COLLAGENE" is French for "collagen."

The following translation statement is suggested:

**The English translation of the wording "COLLAGENE" in the mark is "collagen."**

TMEP §809.02.

### **DISCLAIMER OF DESCRIPTIVE WORDING REQUIRED**

Applicant must disclaim the descriptive wording "EXTRA VOLUME COLLAGENE" apart from the mark as shown because it merely describes a feature or characteristic of applicant's goods. *See* 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a).

Specifically, the wording "EXTRA VOLUME" merely indicates that applicant's mascaras are intended to give the user's eyelashes additional (i.e., extra) thickness (i.e., volume). The wording "COLLAGENE" is the French equivalent of the wording "collagen," which merely indicates that applicant's mascaras contain a particular type of protein (i.e., collagen). Please see the attached supporting dictionary evidence, which defines (a) "extra" as "more than usual: added to, or over and above, the usual, original, or necessary amount" or "more and better: greater in degree and of better quality than is normal;" (b) "volume" as "thickness: the thick quality or appearance of somebody's hair" or "the total amount of something;" (c) "collagene" as the French equivalent of "collagen;" and (d) "collagen" as "connective protein: a fibrous protein found in skin, bone, and other connective tissues."

The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements or combinations thereof. 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). See TMEP §§1213, 1213.03. In addition, applicant is advised that the English translation of non-English wording in the mark that is descriptive or generic in connection with the identified goods and/or services is an unregistrable component of the mark and thus is subject to a proper disclaimer requirement in the same way that the English version of such wording would be subject to a disclaimer. See TMEP §§1213.03(a), 1213.08(d).

Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

A “disclaimer” is a statement that applicant does not claim exclusive rights to an unregistrable component of a mark. TMEP §1213. A disclaimer does not affect the appearance of the applied-for mark. See TMEP §1213.10.

If foreign wording must be disclaimed, the disclaimer statement must refer to the actual non-English wording that appears in the mark, not the English translation of that wording. TMEP §1213.08(d).

The computerized printing format for the Office’s *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

**No claim is made to the exclusive right to use “EXTRA VOLUME COLLAGENE” apart from the mark as shown.**

TMEP §1213.08(a)(i); see *In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

### **OWNERSHIP OF PRIOR REGISTRATIONS**

If applicant is the owner of U.S. Registration Nos. 0540541, 0661746, and others (see attached registrations), then applicant must submit a claim of ownership. 37 C.F.R. §2.36; TMEP §812. The following standard format is suggested:

**Applicant is the owner of U.S. Registration Nos. 0540541, 0661746, and others.**

**Because the above issue can be resolved through the issuance of an Examiner’s Amendment, applicant’s attorney is encouraged to expedite the application process by contacting the assigned examining attorney at the phone number below in order to authorize the necessary changes to the application record.**

/Robert J. Lavache/  
Examining Attorney  
Law Office 108

Phone: (571) 272-5881

Fax: (571) 273-9108

**RESPOND TO THIS ACTION:** Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

**Print: Sep 3, 2008**

**71597300**

**DESIGN MARK**

**Serial Number**

71597300

**Status**

REGISTERED AND RENEWED

**Word Mark**

L'OREAL

**Standard Character Mark**

No

**Registration Number**

0540541

**Date Registered**

1951/04/03

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

**Owner**

L'OREAL CORPORATION FRANCE 14, RUE ROYALE PARIS CEDEX FRANCE 75008

**Goods/Services**

Class Status -- ACTIVE. IC 003. US 051. G & S: ROUGE, FACE CREAM, HAIR LOTION, HAND CREAM, EYE SHADOW, FACE LOTION, PERFUME, COLOGNE, NAIL POLISH, SUNTAN OIL AND FACE POWDER.

**Foreign Country Name**

FRANCE

**Foreign Registration Number**

375704

**Foreign Registration Date**

1947/03/13

**Filing Date**

1950/05/11

**Examining Attorney**

UNKNOWN

**Print: Sep 3, 2008**

**71597300**

**Attorney of Record**

THOMAS S. BAKER JR.

L'ORÉAL

**Print: Sep 3, 2008**

**72010934**

**TYPED DRAWING**

**Serial Number**

72010934

**Status**

REGISTERED AND RENEWED

**Word Mark**

L'OREAL

**Standard Character Mark**

No

**Registration Number**

0661746

**Date Registered**

1958/05/13

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(1) TYPED DRAWING

**Owner**

L'OREAL SOCIETE ANONYME FRANCE 14, RUE ROYALE PARIS FRANCE 75008

**Goods/Services**

Class Status -- ACTIVE. IC 003. US 051. G & S: HAIR COLORINGS, COLOR RINSES, HAIR BLEACHES, COLOR DEVELOPERS, COLOR INTENSIFIERS, AND HAIR CONDITIONERS. First Use: 1921/02/22. First Use In Commerce: 1921/02/22.

**Prior Registration(s)**

0540541;0564689

**Filing Date**

1956/06/25

**Examining Attorney**

UNKNOWN

**Attorney of Record**

Robert L. Sherman

a child dies  
from preventable causes



Look up:  French-English

Voir également :

Colisée  
colistier  
colite  
collabo  
collaborant  
collaborateur  
collaboration  
collaborationniste  
collaborer  
collage  
collagène  
collant  
collante  
collants  
collapsus  
collatérale  
collatéraux  
collation  
collationner  
collé  
colle

**collagene:** en español | in context | images  
verb conjugator

**collagène:**  
**collagène** nm collagen

**Forums WR : discussions dont le titre comprend le mot "collagene".**

- Aucun titre ne contient le(s) mot(s) 'collagene'.
- Pour poser la question dans les forums
  - Pour visiter le forum Français-Anglais.

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↑  
extinction  
extinguish  
extinguisher  
extirpate  
extol  
extort  
extortion  
extortionate  
▶ **extra**  
extra-  
extra-base hit  
extra cover  
extra end  
extra point  
extra time  
extra-virgin

extra

ex·tra [ ékstra ]

adjective

Definition:

1. more than usual: added to, or over and above, the usual, original, or necessary amount

• Take extra precautions when traveling in bad weather.

2. more and better: greater in degree

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extra-virgin  
olive oil  
extracanonical



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Dictionary

**2. more and better:** greater in degree and of better quality than is normal

**3. charged for in addition:** charged for in addition to the basic cost

- *You get one free drink with the meal; further drinks are extra.*

adverb

#### Definition:

**exceptionally:** to a greater extent than is usual or expected

- *Be extra careful at that crossing.*

pron

#### Definition:

**more:** more than the usual amount or price

- *The hotel charges extra for cable TV.*

noun (plural extras)

#### Definition:

**1. something charged for in addition:** something for which an additional charge is made, or the additional




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Lights & lanterns

additional charge is made, or the additional charge itself

- *Make sure there are no hidden extras.*

**2. something additional:** something additional or unexpected

- *The remaining items are optional extras.*

**3. MOVIES nonspeaking movie**

**actor:** somebody employed in a minor, usually nonspeaking, part in a movie, e.g. in a crowd scene

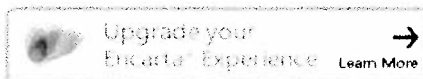
**4. PRESS special edition of**

**newspaper:** a special edition of a newspaper or magazine, often reporting later news or concentrating on a particular subject

- *a sports extra*

**5. U.S. Excellent thing:** something of exceptionally high quality

[Mid-17th century. Probably shortening of extraordinary]



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ABCDEFGHIJKLMNOPQRSTUVWXYZ

↑

voltaic pile  
voltaism  
voltaroi  
volte (1)  
volte (2)  
volte-face  
voltmeter  
voluble  
▶ **volume**  
volume discount  
volumed  
volumeter  
volumetric  
volumetric analysis  
voluminous  
voluntarism  
voluntary

↓

Print Preview

volume

⏮ ⏭ volume

**vol·ume** [ vŏl'yŭm, vŏl'yŭm ]

noun (*plural* vol·umes)

**Definition:**

1. **space inside object:** the size of a three-dimensional space enclosed within or occupied by an object.  
*Symbol* V

2. **amount:** the total amount of something


3. **loudness:** the loudness of a sound

4. **sound control:** the knob or button on a radio, television, or audio player that controls loudness

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See pronunciation key

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**5. book:** a bound collection of printed or written pages

**6. book of set:** a single book that belongs to a set of books

**7. PUBLISHING consecutive magazine issues:** a set of issues of a periodical spanning one calendar year

**8. thickness:** the thick quality or appearance of somebody's hair

adjective

**Definition:**

**involving large quantities:** using or involving large amounts or quantities

- *offering volume discounts on carpeting*

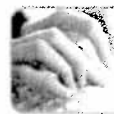
[14th century. Via Old French < Latin *volumen* "roll, scroll, book" < *volvere* "to roll"]

**speak volumes** to be highly expressive or significant

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↑ collagen

colistin  
colitis  
coll-  
coll.  
collaborate  
collaboration  
collaborative  
divorce  
collage  
▶ collagen  
collagen disease  
collagenase  
collapsar  
collapse  
collar  
collarbone  
collard  
collared dove

↓

col·la·gen [kŏl·lajən]  
noun  
Definition:  
connective protein: a fibrous protein found in skin, bone, and other connective tissues  
[Mid-19th century. < French *collagène* < Greek *kolla* "glue"]  
• col·la·gen·ic [kŏl·laj·jĕnik] adjective  
• col·lag·e·nous [kŏl·lāj·jə·nəs] adjective


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
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**To:** L'Oreal ([rls@paulhastings.com](mailto:rls@paulhastings.com))  
**Subject:** TRADEMARK APPLICATION NO. 77477820 - L'OREAL EXTRA  
VOLUME - 29172.00012  
**Sent:** 9/3/2008 4:01:04 PM  
**Sent As:** ECOM108@USPTO.GOV  
**Attachments:**

---

**IMPORTANT NOTICE**  
**USPTO OFFICE ACTION HAS ISSUED ON 9/3/2008 FOR**  
**APPLICATION SERIAL NO. 77477820**

Please follow the instructions below to continue the prosecution of your application:

**VIEW OFFICE ACTION:** Click on this link  
[http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial\\_number=77477820&doc\\_type=OOA&](http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77477820&doc_type=OOA&)  
(or copy and paste this URL into the address field of your browser), or visit  
<http://tmportal.uspto.gov/external/portal/tow> and enter the application serial number to access the  
Office action.

**PLEASE NOTE:** The Office action may not be immediately available but will be viewable within 24 hours of this notification.

**RESPONSE MAY BE REQUIRED:** You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable response time period. Your response deadline will be calculated from 9/3/2008.

**Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.**

**HELP:** For *technical* assistance in accessing the Office action, please e-mail [TDR@uspto.gov](mailto:TDR@uspto.gov). Please contact the assigned examining attorney with questions about the Office action.

**WARNING**

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the**



**ABANDONMENT of your application.**

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77477820
LAW OFFICE ASSIGNED	LAW OFFICE 108
MARK SECTION (no change)	
ARGUMENT(S)	
<b>I. <u>REQUIREMENT FOR A DISCLAIMER OF "VOLUME COLLAGEN"</u></b>	
<b>A. DISCLAIMER OF "EXTRA" and "COLLAGEN"</b>	
Please amend the application by including the following statement:	
No claim is made to the exclusive right to use "EXTRA" or "COLLAGEN" apart from the mark as shown.	
<b>B. DISCLAIMER OF "EXTRA VOLUME COLLAGENE"</b>	
<p>Although Applicant agrees to disclaim the words "extra" and "collagen," it contests the Examining Attorney's request that Applicant disclaim the term "EXTRA VOLUME COLLAGENE" on the ground that it "merely describes a feature or characteristic of applicant's goods." The Examining Attorney fails to adequately describe what the phrase "extra volume collagene" merely describes, and instead offers separate definitions of the words "extra" and "volume" and "collagen," each entirely independent of the others. That position is flawed in a number of ways. The disclaimer requirement is based on the Examining Attorney's improper dissection of the phrase that it seeks to have disclaimed, a practice the Trademark Office has deemed improper. Even if improperly dissected, the word VOLUME is not merely descriptive of the goods in question as evidenced by the various meanings that VOLUME-formative marks can convey to consumers. Further, the Trademark Office has repeatedly recognized that VOLUME is not merely descriptive of the identified goods, as evidenced by the vast majority of VOLUME-formative marks registered for mascaras that do not disclaim that term, as well as by the published application to register L'ORÉAL VOLUME COLLAGENE which does not disclaim "volume" either alone or within a phrase. Applicant thus requests that the Examining Attorney reconsider his refusal and allow Applicant's mark to proceed to publication without disclaiming "EXTRA VOLUME COLLAGENE," a phrase that has no precise or merely descriptive meaning in the English language.</p>	
<b>1. Improper Dissection of the Mark</b>	

It is well-settled that a mark must be examined in its entirety, not by dissecting it and evaluating its component parts. Although an Examining Attorney may address the potential mere descriptiveness of individual elements of a mark, that may be done *only* as a preliminary step in determining the overall effect of the mark. It is the commercial impression of the mark as a whole that is relevant, not its individual components. Therefore, it is imperative that the Examining Attorney's "ultimate determination is made on the basis of the mark in its entirety." *In re Hester Industries, Inc.*, 230 U.S.P.Q. 797, 799 n.5 (T.T.A.B. 1986) (holding that THIGHSTIX is not merely descriptive for boneless chicken); *see also In re HEB Grocery Co., LP*, 2004 WL 2619562, at \*3 (T.T.A.B. Oct. 7, 2004) ("We must obviously consider the mark as a whole in determining whether the mark is merely descriptive because, even if the individual terms are descriptive, the mark as a whole may not be."); *In re Central & South*, 2002 WL 139739, at \*2 (T.T.A.B. Feb. 1, 2002) ("we must view the mark as a whole and not dissect the mark and find it descriptive based on its individual components"); 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:27 (4th ed. 2007).

Moreover, as Professor McCarthy has stated: "[t]he combination of two or more admittedly descriptive elements as a composite mark may result in a composite which is nondescriptive. That is, the commercial impression of a composite mark may be arbitrary or suggestive even though its separate parts are descriptive." *Id.* at § 11:26. Thus, the composite mark L'ORÉAL EXTRA VOLUME COLLAGENE must be analyzed for its overall meaning, impression, and connotation. Any attempt to dissect the individual words comprising the mark in order to require a disclaimer of EXTRA VOLUME COLLAGENE would contradict the well-established practice and precedent of the Patent and Trademark Office of considering marks in their entireties. *See In re Diamond Walnut Growers, Inc.*, 183 U.S.P.Q. 63, 64 (T.T.A.B. 1974); *see also In re Chesapeake Corp. of Va.*, 420 F.2d 754, 756 (C.C.P.A. 1970) (reversing the Trademark Office's refusal to register a mark based upon mere descriptiveness, where the mark, which was not merely descriptive when viewed in its entirety, could only be considered merely descriptive if its individual words were improperly dissected); *In re IBM Corp.*, 2008 WL 853824, at \*5 (T.T.A.B. Jan. 28, 2008) (reversing ruling that mark was merely descriptive, where "[g]iven the dictionary definitions of record, the individual words comprising applicant's mark have commonly understood meanings. We do not believe, however, that the *specific combination* of the words [comprising the mark] results in a designation which, when *considered in its entirety*, is merely descriptive of applicant's goods and services.") (emphasis added).

The Examining Attorney dissects the words "extra," "volume" and "collagene." The requirement that Applicant disclaim "extra volume collagene" is improper and should be withdrawn.

## **2. Standard for Evaluating Whether a Mark is "Merely Descriptive"**

It is well-established that a mark is merely descriptive only if it directly conveys knowledge of the quality, feature, function or characteristics of the product or services. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963 (Fed. Cir. 2007). The requirement to disclaim EXTRA VOLUME COLLAGENE would be proper only if those words as an integral term were merely descriptive of the goods or services. *See* TMEP § 1213.03(a) (5th ed. 2007). As Professor McCarthy states:

Under the Lanham Act, as under the common law, one of the tests to determine whether a mark is "merely descriptive" is based upon what the mark would mean to the potential customer when applied to the applicant's goods.

The word "merely" in the Act apparently means that if the mark clearly

does not tell the potential customer only what the goods are, their function, characteristics, use or ingredients, then the mark is not "merely descriptive."

2 McCarthy on Trademarks and Unfair Competition § 11:51 at 1114.6-14.7. *See also In re Pennzoil Products Co.*, 20 U.S.P.Q.2d 1753, 1755 (T.T.A.B. 1991) ("It is well settled that a term is considered to be merely descriptive of goods or services . . . if it *immediately* describes an ingredient, quality, characteristic or feature thereof or if it *directly* conveys information regarding the nature, function, purpose or use of the goods or services.") (emphasis added).

Marks that are "merely 'laudatory' and descriptive of the alleged merit of a product" fall within the rubric of descriptive marks. 2 McCarthy on Trademarks and Unfair Competition § 11:17 at 11-24. In contrast, a mark is suggestive if it requires "a multistage reasoning process, or the utilization of imagination, thought or perception," to be able to determine the nature of applicant's product. ||| *Plyboo America, Inc. v. Smith & Fong Co.*, 51 U.S.P.Q.2d 1633, 1640 (T.T.A.B. 1999); *In re MBNA Am. Bank N.A.*, 340 F.3d 1328, 67 U.S.P.Q.2d 1778, 1780 (Fed. Cir. 2003). There is a "thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment." *Id.* Where there is any doubt regarding whether a mark is descriptive, that doubt must be resolved in favor of the applicant. *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987).

As the cases and commentary make clear, the key component of the "merely descriptive" test is not whether the mark can, in some manner, arguably be considered descriptive. Rather, the proper consideration is whether the function, characteristics or use of the mark in relation to Applicant's goods is immediately and directly conveyed. The Board, by using such terms as "*immediately*" and "*directly*" has imposed a high threshold for categorizing a term as merely descriptive - a threshold that the phrase EXTRA VOLUME COLLAGENE does not cross as used in Applicant's L'ORÉAL EXTRA VOLUME COLLAGENE mark.

### **3. VOLUME is Not Merely Descriptive of Applicant's Goods**

As the basis for his disclaimer requirement, the Examining Attorney states that the term VOLUME, as used in the term EXTRA VOLUME COLLAGENE that the Examining Attorney has required be disclaimed, is defined as "thickness: the thick quality or appearance of somebody's hair" or "the total amount of something." The fact that the Office action itself concedes that "volume" can be given two entirely different meanings when used with the identified goods is evidence that the term is not *merely descriptive* when used in the connection with Applicant's goods. Further, the fact that the Office action fails to demonstrate how either of those definitions combines with the term "collagene" to merely describe Applicant's goods evidences that the phrase in its entirety is not merely descriptive.

The mark L'ORÉAL EXTRA VOLUME COLLAGENE, used in connection with Applicant's goods, is susceptible of a number of reasonable interpretations. As a result, neither does Applicant's mark in its entirety, the phrase EXTRA VOLUME COLLAGENE, nor the term VOLUME as used within the mark, "immediately" or "directly" describe the goods identified in Applicant's application. Thus, the assertion that the string of words "merely describes a feature or characteristic of applicant's goods" is vague, overbroad and, ultimately, improper.

When one analyzes the required disclaimer of EXTRA VOLUME COLLAGENE, the word "volume" conveys a number of different commercial impressions. That is because "volume" has several

meanings. In fact, the very dictionary cited by the Examining Attorney, Encarta®, located at <http://encarta.msn.com/dictionary/volume.html>, last accessed on March 2, 2009, contains several definitions that could apply to mascaras, including:

- "the size of a three-dimensional space enclosed within or occupied by an object"
- "the total amount of something"
- "the thick quality or appearance of somebody's hair"
- "using or involving large amounts of quantities" or
- "to be highly expressive or significant." *Id.*

Similarly, another frequently-used online dictionary, Merriam-Webster Online Dictionary, <http://www.m-w.com/dictionary/volume>, last accessed on March 2, 2009, also contains several definitions that could apply to mascaras, including:

- "the amount of space occupied by a three-dimensional object as measured in cubic units (as quarts or liters)"
- "cubic capacity"
- "a considerable quantity"
- "the amount of a substance occupying a particular volume" or
- "mass or the representation of mass in art." *Id.*

Given the above possibilities, a consumer may easily perceive of a number of different meanings for "volume" when the term is used with mascaras -- the antithesis of mere descriptiveness. The Examining Attorney offers the bald assertion that EXTRA VOLUME COLLAGENE "merely describes a feature or characteristic of applicant's goods." However, given the various definitions of "volume," a consumer may interpret Applicant's mark in a number of different ways. Therefore, the Examining Attorney's determination that the term is merely descriptive, when only considering one of the numerous available interpretations of "volume," is improper and insufficient as a basis for a disclaimer requirement. *See In re Diet Tabs, Inc.*, 231 U.S.P.Q. 587, 588 (T.T.A.B. 1986) (reversing the Examining Attorney's mere descriptiveness refusal where the refusal was based on only one of several possible meanings for "diet").

It is not clear whether the Examining Attorney believes the mark merely describes (a) the mascara itself, (b) the consumer's eyelashes, (c) the effect that the mascara would have on the consumer's eyelashes, or (d) the collagen. That ambiguity in and of itself demonstrates that the mark is not *merely* descriptive. For example, a consumer could fairly perceive that L'ORÉAL EXTRA VOLUME COLLAGENE is a product that can be used to increase the amount of space that is occupied by a consumer's eyelashes. Some consumers may perceive the mark to reference the masacara's ability to make one's eyelashes "highly expressive or significant." Alternatively, L'ORÉAL EXTRA VOLUME COLLAGENE could be perceived as a product that contains a large quantity of collagen. L'ORÉAL EXTRA VOLUME COLLAGENE is also likely to be perceived by some consumers to be a product that maximizes or amplifies the amount of the collagen that is already naturally present in a consumer's eyelashes. Those are just four of the numerous potential ways in which consumers may perceive L'ORÉAL EXTRA VOLUME COLLAGENE. As previously noted, "volume," as used in EXTRA VOLUME COLLAGENE, can be viewed in a number of different ways, and the experiences and expectations of consumers with respect to mascaras, the protein collagen, and Applicant's products generally will influence how the term is perceived. As a result, finding the phrase EXTRA VOLUME COLLAGENE to be *merely descriptive* of Applicant's goods by singling out one of a number of meanings is

inappropriate.

When making a determination as to whether a mark is *merely* descriptive of the goods with which it is associated, one must consider whether words or word combinations are commonly used or whether some measure of "mental pause" is required to connect those words to the product in question. *See In re Dayan*, 61 F. App'x 695, 697, 2003 WL 932442, at \*2 (Fed. Cir. 2003) ("The concept of mere descriptiveness, it seems to us, must relate to general and readily recognizable word formulations and meanings, either in a popular or technical usage context, and should not penalize coinage or hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and "mental pause.") Under the proper legal test, EXTRA VOLUME COLLAGENE cannot be considered to be *merely descriptive* of the goods in question. *See In re Nett Designs, Inc.*, 57 U.S.P.Q.2d 1564, 1566 (Fed. Cir. 2001) (stating that where a mark "requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods," the mark is not descriptive).

Where a mark has multiple meanings and requires some degree of imagination, thought, or perception to arrive at the qualities or characteristics of the goods, the mark necessarily is not merely descriptive. *Id.* Even when improperly dissected from the rest of the mark and required to be disclaimed as part of a three-word combination, "volume" conveys more than one impression likely to be taken away by consumers. Although one interpretation of the term "indicates that the goods create 'a considerable quantity'" of collagen, it does so "without telling the consumer what that attribute is with 'any degree of particularity.'" *See Plus Prods. v. Med. Modalities Assoc., Inc.*, 211 U.S.P.Q. 1199, 1205 (T.T.A.B. 1981); *In re Diet Tabs, Inc.*, 231 U.S.P.Q. at 588. It is improper for an Examining Attorney to choose one commercial impression from those available and then deem the mark to be merely descriptive of that one selected impression. *See Dial-A-Mattress Operating Corp. v. Mattress Madness, Inc.*, 841 F. Supp. 1339, 1347 (E.D.N.Y. 1994) ("The phrase 'dial-a-mattress,' while certainly establishing a link between the telephone and bedding products, does not begin to describe the nature, scope or extent of the services that the name has come to represent.").

**4. The Trademark Office has Repeatedly Recognized That the Term "VOLUME" is Not**

**Merely Descriptive When Used in Connection With Applicant's Goods**

**a. Applicant's Successful Recent Application for L'ORÉAL VOLUME COLLAGENE**

The Trademark Office already determined, less than two months ago, that the phrase VOLUME COLLAGENE *is not merely descriptive* of mascaras and need not be disclaimed.

On May 5, 2008, two weeks before this application was filed, L'Oréal filed an application to register L'ORÉAL VOLUME COLLAGENE for use with mascaras (the identical products at issue here). That application was assigned Serial Number 77/461,637. Approximately one month after filing, on June 10, 2008, an Office action was issued in connection with that application requiring a disclaimer of the term "volume collagene." In response to that Office action, L'Oréal stated that the phrase "volume collagene" has no plain meaning and that, because of the numerous meanings presented by the word "volume," the phrase could not properly be considered *merely descriptive* of mascara. Upon consideration of that evidence, the requirement to disclaim "volume collagene" was withdrawn, a disclaimer of the word "collagen" was entered, and the application proceeded to publication on January 27, 2009.

The Trademark Office is encouraged by the Court of Appeals for the Federal Circuit to use a uniform standard in assessing marks. *In re Nett Designs*, 57 U.S.P.Q.2d at 1566 ("Needless to say, this

court encourages the PTO to achieve a uniform standard for assessing registrability of marks."). An applicant is entitled to a certain degree of reliance on the Trademark Office's treatment of similar marks.

In accordance with those policies, the Court of Appeals for the Federal Circuit, in *In re Merrill Lynch*, specifically held that the analysis of whether a mark is descriptive is to be undertaken "in accordance with practice and precedent." 828 F. 2d at 1571.

It would be contrary to practice and precedent, and prejudicial to Applicant, now to require a disclaimer of the phrase EXTRA VOLUME COLLAGENE when the Trademark Office already has announced that VOLUME COLLAGENE is not merely descriptive when used with mascaras.

**b. The Trademark Office's Past Findings that "VOLUME" is Not Merely Descriptive of Mascaras**

Further supporting the fact that "volume" is not merely descriptive of the identified goods, a search of the Principal Register demonstrates that the Trademark Office regularly permits registration of VOLUME-formative marks for a variety of goods in Class 3, including mascaras, without disclaimer.

The existence of numerous registrations for VOLUME-formative marks for mascaras and other Class 3 goods without disclaimer establishes that the Trademark Office recognizes that "volume," as it is used within the term required to be disclaimed -- EXTRA VOLUME COLLAGENE -- is not *merely descriptive* when used with personal care products. In addition to the very recent publication of L'ORÉAL VOLUME COLLAGENE without disclaimer of "volume," two years prior the Trademark Office registered Applicant's mark VOLUME SHOCKING for use with mascaras (Reg. No. 3,174,583) without disclaimer of "volume." *See infra*. Similarly, the Trademark Office previously permitted Applicant to register the mark VOLUME PERFECT for use with lipcolor (Reg. No. 2,923,953) without disclaimer. As stated by the Board in *In re Consolidated Cigar*, 35 U.S.P.Q. 2d 1290, 1295 (T.T.A.B. 1995), "[u]niform treatment under the Trademark Act is desirable." In conformity with its other actions and decisions concerning VOLUME-formative marks, including those examples listed below and the recent publication of L'ORÉAL VOLUME COLLAGENE, the Trademark Office should permit Applicant to register L'ORÉAL EXTRA VOLUME COLLAGENE without a disclaimer of "volume."

The chart below contains examples of current registrations of VOLUME-formative marks for mascaras that do not disclaim "volume":

Mark	Owner	Reg. No.	Goods
VOLUME SHOCKING	L'Oréal	3,174,583	Mascara
HEALTHY VOLUME	Neutrogena Corp.	3,402,544	Mascara
WONDER VOLUME	Clarins S.A.	3,042,400	Mascara
WEIGHTLESS VOLUME	Neutrogena Corp.	2,595,906	Mascara
VOLUME GLAMOUR	Bourjois	2,563,629	Mascara
FULL VOLUME	Neutrogena Corp.	2,427,571	Mascara
VOLUME EFFECT	Amorepacific Corp.	2,936,930	Mascara and other eye-related personal care products

See Exhibit A.

As illustrated by the foregoing registrations, the term "volume," as it is used in the term now required to be disclaimed, is not *merely descriptive* when used with mascara. Requiring a disclaimer of EXTRA VOLUME COLLAGENE in the application for L'ORÉAL EXTRA VOLUME COLLAGENE would be inconsistent with prior practice and precedent, *see In re Nett Designs*, 57 U.S.P.Q.2d at 1566, and would run afoul of the "practice and precedent" established by the Trademark Office's treatment of similar marks. *In re Merrill Lynch*, 828 F.2d at 1571 (holding that the analysis of whether a mark is descriptive is to be undertaken "in accordance with practice and precedent").

## II. CONCLUSION

In view of the foregoing, Applicant respectfully requests that the disclaimer requirement with respect to the phrase "EXTRA VOLUME COLLAGENE" be withdrawn and that Application Ser. No. 77/477,820 be approved for publication.

[1] Applicant does not concede that L'ORÉAL EXTRA VOLUME COLLAGENE is suggestive. It points out only that the mark is not merely descriptive.

## EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	<u>evi_21624125030-171125277_ Exhibit A -</u> <u>ROA for L OREAL EXTRA VOLUME COLLAGENE.pdf</u>
CONVERTED PDF FILE(S) (11 pages)	<u>\\TICRS\EXPORT6\IMAGEOUT6\774\778\77477820\xml\1\ROA0002.JPG</u>
	<u>\\TICRS\EXPORT6\IMAGEOUT6\774\778\77477820\xml\1\ROA0003.JPG</u>
	<u>\\TICRS\EXPORT6\IMAGEOUT6\774\778\77477820\xml\1\ROA0004.JPG</u>
	<u>\\TICRS\EXPORT6\IMAGEOUT6\774\778\77477820\xml\1\ROA0005.JPG</u>
	<u>\\TICRS\EXPORT6\IMAGEOUT6\774\778\77477820\xml\1\ROA0006.JPG</u>
	<u>\\TICRS\EXPORT6\IMAGEOUT6\774\778\77477820\xml\1\ROA0007.JPG</u>
	<u>\\TICRS\EXPORT6\IMAGEOUT6\774\778\77477820\xml\1\ROA0008.JPG</u>
	<u>\\TICRS\EXPORT6\IMAGEOUT6\774\778\77477820\xml\1\ROA0009.JPG</u>
	<u>\\TICRS\EXPORT6\IMAGEOUT6\774\778\77477820\xml\1\ROA0010.JPG</u>
	<u>\\TICRS\EXPORT6\IMAGEOUT6\774\778\77477820\xml\1\ROA0011.JPG</u>
	<u>\\TICRS\EXPORT6\IMAGEOUT6\774\778\77477820\xml\1\ROA0012.JPG</u>
DESCRIPTION OF EVIDENCE FILE	Exhibit A - Registrations Cited in Argument

## ADDITIONAL STATEMENTS SECTION



<b>PRIOR REGISTRATION(S)</b>	Applicant claims ownership of U.S. Registration Number(s) 0540541, 0661746.
<b>TRANSLATION</b>	The English translation of COLLAGENE in the mark is COLLAGEN.
<b>SIGNATURE SECTION</b>	
<b>DECLARATION SIGNATURE</b>	The filing Attorney has elected not to submit the signed declaration, believing no supporting declaration is required under the <i>Trademark Rules of Practice</i> .
<b>RESPONSE SIGNATURE</b>	/bey/
<b>SIGNATORY'S NAME</b>	Bradford E. Young
<b>SIGNATORY'S POSITION</b>	Attorney for Applicant, New York bar member
<b>DATE SIGNED</b>	03/03/2009
<b>AUTHORIZED SIGNATORY</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Tue Mar 03 17:35:48 EST 2009
<b>TEAS STAMP</b>	USPTO/ROA-216.241.250.30- 20090303173548233355-7747 7820-44046352a26116bab472 ae2e16855e649c-N/A-N/A-20 090303171125277262

**Response to Office Action  
To the Commissioner for Trademarks:**

Application serial no. **77477820** has been amended as follows:

**ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

- I.      REQUIREMENT FOR A DISCLAIMER OF "VOLUME COLLAGEN"**  
**A.      DISCLAIMER OF "EXTRA" and "COLLAGEN"**

Please amend the application by including the following statement:

No claim is made to the exclusive right to use "EXTRA" or "COLLAGEN" apart from the mark as shown.

## **B. DISCLAIMER OF "EXTRA VOLUME COLLAGENE"**

Although Applicant agrees to disclaim the words "extra" and "collagen," it contests the Examining Attorney's request that Applicant disclaim the term "EXTRA VOLUME COLLAGENE" on the ground that it "merely describes a feature or characteristic of applicant's goods." The Examining Attorney fails to adequately describe what the phrase "extra volume collagene" merely describes, and instead offers separate definitions of the words "extra" and "volume" and "collagen," each entirely independent of the others. That position is flawed in a number of ways. The disclaimer requirement is based on the Examining Attorney's improper dissection of the phrase that it seeks to have disclaimed, a practice the Trademark Office has deemed improper. Even if improperly dissected, the word VOLUME is not merely descriptive of the goods in question as evidenced by the various meanings that VOLUME-formative marks can convey to consumers. Further, the Trademark Office has repeatedly recognized that VOLUME is not merely descriptive of the identified goods, as evidenced by the vast majority of VOLUME-formative marks registered for mascaras that do not disclaim that term, as well as by the published application to register L'ORÉAL VOLUME COLLAGENE which does not disclaim "volume" either alone or within a phrase. Applicant thus requests that the Examining Attorney reconsider his refusal and allow Applicant's mark to proceed to publication without disclaiming "EXTRA VOLUME COLLAGENE," a phrase that has no precise or merely descriptive meaning in the English language.

### **1. Improper Dissection of the Mark**

It is well-settled that a mark must be examined in its entirety, not by dissecting it and evaluating its component parts. Although an Examining Attorney may address the potential mere descriptiveness of individual elements of a mark, that may be done *only* as a preliminary step in determining the overall effect of the mark. It is the commercial impression of the mark as a whole that is relevant, not its individual components. Therefore, it is imperative that the Examining Attorney's "ultimate determination is made on the basis of the mark in its entirety." *In re Hester Industries, Inc.*, 230 U.S.P.Q. 797, 799 n.5 (T.T.A.B. 1986) (holding that THIGHSTIX is not merely descriptive for boneless chicken); *see also In re HEB Grocery Co., LP*, 2004 WL 2619562, at \*3 (T.T.A.B. Oct. 7, 2004) ("We must obviously consider the mark as a whole in determining whether the mark is merely descriptive because, even if the individual terms are descriptive, the mark as a whole may not be."); *In re Central & South*, 2002 WL 139739, at \*2 (T.T.A.B. Feb. 1, 2002) ("we must view the mark as a whole and not dissect the mark and find it descriptive based on its individual components"); 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:27 (4th ed. 2007).

Moreover, as Professor McCarthy has stated: "[t]he combination of two or more admittedly descriptive elements as a composite mark may result in a composite which is nondescriptive. That is, the commercial impression of a composite mark may be arbitrary or suggestive even though its separate parts are descriptive." *Id.* at § 11:26. Thus, the composite mark L'ORÉAL EXTRA VOLUME COLLAGENE must be analyzed for its overall meaning, impression, and connotation. Any attempt to dissect the individual words comprising the mark in order to require a disclaimer of EXTRA VOLUME COLLAGENE would contradict the well-established practice and precedent of the Patent and Trademark Office of considering marks in their entireties. *See In re Diamond Walnut Growers, Inc.*, 183 U.S.P.Q. 63,

64 (T.T.A.B. 1974); *see also In re Chesapeake Corp. of Va.*, 420 F.2d 754, 756 (C.C.P.A. 1970) (reversing the Trademark Office's refusal to register a mark based upon mere descriptiveness, where the mark, which was not merely descriptive when viewed in its entirety, could only be considered merely descriptive if its individual words were improperly dissected); *In re IBM Corp.*, 2008 WL 853824, at \*5 (T.T.A.B. Jan. 28, 2008) (reversing ruling that mark was merely descriptive, where "[g]iven the dictionary definitions of record, the individual words comprising applicant's mark have commonly understood meanings. We do not believe, however, that the *specific combination* of the words [comprising the mark] results in a designation which, when *considered in its entirety*, is merely descriptive of applicant's goods and services.") (emphasis added).

The Examining Attorney dissects the words "extra," "volume" and "collagene." The requirement that Applicant disclaim "extra volume collagene" is improper and should be withdrawn.

## **2. Standard for Evaluating Whether a Mark is "Merely Descriptive"**

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Under the Lanham Act, as under the common law, one of the tests to determine whether a mark is "merely descriptive" is based upon what the mark would mean to the potential customer when applied to the applicant's goods.

The word "merely" in the Act apparently means that if the mark clearly does not tell the potential customer only what the goods are, their function, characteristics, use or ingredients, then the mark is not "merely descriptive."

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As the cases and commentary make clear, the key component of the "merely descriptive" test is not whether the mark can, in some manner, arguably be considered descriptive. Rather, the proper consideration is whether the function, characteristics or use of the mark in relation to Applicant's goods is immediately and directly conveyed. The Board, by using such terms as "*immediately*" and "*directly*" has

imposed a high threshold for categorizing a term as merely descriptive - a threshold that the phrase EXTRA VOLUME COLLAGENE does not cross as used in Applicant's L'ORÉAL EXTRA VOLUME COLLAGENE mark.

### 3. VOLUME is Not Merely Descriptive of Applicant's Goods

As the basis for his disclaimer requirement, the Examining Attorney states that the term VOLUME, as used in the term EXTRA VOLUME COLLAGENE that the Examining Attorney has required be disclaimed, is defined as "thickness: the thick quality or appearance of somebody's hair" or "the total amount of something." The fact that the Office action itself concedes that "volume" can be given two entirely different meanings when used with the identified goods is evidence that the term is not *merely descriptive* when used in the connection with Applicant's goods. Further, the fact that the Office action fails to demonstrate how either of those definitions combines with the term "collagene" to merely describe Applicant's goods evidences that the phrase in its entirety is not merely descriptive.

The mark L'ORÉAL EXTRA VOLUME COLLAGENE, used in connection with Applicant's goods, is susceptible of a number of reasonable interpretations. As a result, neither does Applicant's mark in its entirety, the phrase EXTRA VOLUME COLLAGEN, nor the term VOLUME as used within the mark, "immediately" or "directly" describe the goods identified in Applicant's application. Thus, the assertion that the string of words "merely describes a feature or characteristic of applicant's goods" is vague, overbroad and, ultimately, improper.

When one analyzes the required disclaimer of EXTRA VOLUME COLLAGENE, the word "volume" conveys a number of different commercial impressions. That is because "volume" has several meanings. In fact, the very dictionary cited by the Examining Attorney, Encarta®, located at <http://encarta.msn.com/dictionary/volume.html>, last accessed on March 2, 2009, contains several definitions that could apply to mascaras, including:

- "the size of a three-dimensional space enclosed within or occupied by an object"
- "the total amount of something"
- "the thick quality or appearance of somebody's hair"
- "using or involving large amounts of quantities" or
- "to be highly expressive or significant." *Id.*

Similarly, another frequently-used online dictionary, Merriam-Webster Online Dictionary, <http://www.m-w.com/dictionary/volume>, last accessed on March 2, 2009, also contains several definitions that could apply to mascaras, including:

- "the amount of space occupied by a three-dimensional object as measured in cubic units (as quarts or liters)"
- "cubic capacity"
- "a considerable quantity"
- "the amount of a substance occupying a particular volume" or
- "mass or the representation of mass in art." *Id.*

Given the above possibilities, a consumer may easily perceive of a number of different meanings for "volume" when the term is used with mascaras -- the antithesis of mere descriptiveness. The Examining Attorney offers the bald assertion that EXTRA VOLUME COLLAGENE "merely describes a feature or characteristic of applicant's goods." However, given the various definitions of "volume," a consumer may

interpret Applicant's mark in a number of different ways. Therefore, the Examining Attorney's determination that the term is merely descriptive, when only considering one of the numerous available interpretations of "volume," is improper and insufficient as a basis for a disclaimer requirement. *See In re Diet Tabs, Inc.*, 231 U.S.P.Q. 587, 588 (T.T.A.B. 1986) (reversing the Examining Attorney's mere descriptiveness refusal where the refusal was based on only one of several possible meanings for "diet").

It is not clear whether the Examining Attorney believes the mark merely describes (a) the mascara itself,

(b) the consumer's eyelashes, (c) the effect that the mascara would have on the consumer's eyelashes, or (d) the collagen. That ambiguity in and of itself demonstrates that the mark is not *merely* descriptive. For example, a consumer could fairly perceive that L'ORÉAL EXTRA VOLUME COLLAGENE is a product that can be used to increase the amount of space that is occupied by a consumer's eyelashes. Some consumers may perceive the mark to reference the mascara's ability to make one's eyelashes "highly expressive or significant." Alternatively, L'ORÉAL EXTRA VOLUME COLLAGENE could be perceived as a product that contains a large quantity of collagen. L'ORÉAL EXTRA VOLUME COLLAGENE is also likely to be perceived by some consumers to be a product that maximizes or amplifies the amount of the collagen that is already naturally present in a consumer's eyelashes. Those are just four of the numerous potential ways in which consumers may perceive L'ORÉAL EXTRA VOLUME COLLAGENE. As previously noted, "volume," as used in EXTRA VOLUME COLLAGENE, can be viewed in a number of different ways, and the experiences and expectations of consumers with respect to mascaras, the protein collagen, and Applicant's products generally will influence how the term is perceived. As a result, finding the phrase EXTRA VOLUME COLLAGENE to be *merely descriptive* of Applicant's goods by singling out one of a number of meanings is inappropriate.

When making a determination as to whether a mark is *merely* descriptive of the goods with which it is associated, one must consider whether words or word combinations are commonly used or whether some measure of "mental pause" is required to connect those words to the product in question. *See In re Dayan*, 61 F. App'x 695, 697, 2003 WL 932442, at \*2 (Fed. Cir. 2003) ("The concept of mere descriptiveness, it seems to us, must relate to general and readily recognizable word formulations and meanings, either in a popular or technical usage context, and should not penalize coinage or hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and "mental pause.") Under the proper legal test, EXTRA VOLUME COLLAGENE cannot be considered to be *merely descriptive* of the goods in question. *See In re Nett Designs, Inc.*, 57 U.S.P.Q.2d 1564, 1566 (Fed. Cir. 2001) (stating that where a mark "requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods," the mark is not descriptive).

Where a mark has multiple meanings and requires some degree of imagination, thought, or perception to arrive at the qualities or characteristics of the goods, the mark necessarily is not merely descriptive. *Id.* Even when improperly dissected from the rest of the mark and required to be disclaimed as part of a three-word combination, "volume" conveys more than one impression likely to be taken away by consumers. Although one interpretation of the term "indicates that the goods create 'a considerable quantity'" of collagen, it does so "without telling the consumer what that attribute is with 'any degree of particularity.'" *See Plus Prods. v. Med. Modalities Assoc., Inc.*, 211 U.S.P.Q. 1199, 1205 (T.T.A.B. 1981); *In re Diet Tabs, Inc.*, 231 U.S.P.Q. at 588. It is improper for an Examining Attorney to choose one commercial impression from those available and then deem the mark to be merely descriptive of that one selected impression. *See Dial-A-Mattress Operating Corp. v. Mattress Madness, Inc.*, 841 F. Supp. 1339, 1347 (E.D.N.Y. 1994) ("The phrase 'dial-a-mattress,' while certainly establishing a link between the telephone and bedding products, does not begin to describe the nature, scope or extent of the services that the name has come to represent.").

#### **4. The Trademark Office has Repeatedly Recognized That the Term "VOLUME" is Not**

**Merely Descriptive When Used in Connection With Applicant's Goods**

**a. Applicant's Successful Recent Application for L'ORÉAL VOLUME COLLAGENE**

The Trademark Office already determined, less than two months ago, that the phrase VOLUME COLLAGENE *is not merely descriptive* of mascaras and need not be disclaimed.

On May 5, 2008, two weeks before this application was filed, L'Oréal filed an application to register L'ORÉAL VOLUME COLLAGENE for use with mascaras (the identical products at issue here). That application was assigned Serial Number 77/461,637. Approximately one month after filing, on June 10, 2008, an Office action was issued in connection with that application requiring a disclaimer of the term "volume collagene." In response to that Office action, L'Oréal stated that the phrase "volume collagene" has no plain meaning and that, because of the numerous meanings presented by the word "volume," the phrase could not properly be considered *merely descriptive* of mascara. Upon consideration of that evidence, the requirement to disclaim "volume collagene" was withdrawn, a disclaimer of the word "collagen" was entered, and the application proceeded to publication on January 27, 2009.

The Trademark Office is encouraged by the Court of Appeals for the Federal Circuit to use a uniform standard in assessing marks. *In re Nett Designs*, 57 U.S.P.Q.2d at 1566 ("Needless to say, this court encourages the PTO to achieve a uniform standard for assessing registrability of marks."). An applicant is entitled to a certain degree of reliance on the Trademark Office's treatment of similar marks. In accordance with those policies, the Court of Appeals for the Federal Circuit, in *In re Merrill Lynch*, specifically held that the analysis of whether a mark is descriptive is to be undertaken "in accordance with practice and precedent." 828 F. 2d at 1571.

It would be contrary to practice and precedent, and prejudicial to Applicant, now to require a disclaimer of the phrase EXTRA VOLUME COLLAGENE when the Trademark Office already has announced that VOLUME COLLAGENE is not merely descriptive when used with mascaras.

**b. The Trademark Office's Past Findings that "VOLUME" is Not Merely Descriptive of Mascaras**

Further supporting the fact that "volume" is not merely descriptive of the identified goods, a search of the Principal Register demonstrates that the Trademark Office regularly permits registration of VOLUME-formative marks for a variety of goods in Class 3, including mascaras, without disclaimer.

- The existence of numerous registrations for VOLUME-formative marks for mascaras and other Class 3 goods without disclaimer establishes that the Trademark Office recognizes that "volume," as it is used within the term required to be disclaimed -- EXTRA VOLUME COLLAGENE -- is not *merely descriptive* when used with personal care products. In addition to the very recent publication of L'ORÉAL VOLUME COLLAGENE without disclaimer of "volume," two years prior the Trademark Office registered Applicant's mark VOLUME SHOCKING for use with mascaras (Reg. No. 3,174,583) without disclaimer of "volume." *See infra*. Similarly, the Trademark Office previously permitted Applicant to register the mark VOLUME PERFECT for use with lipcolor (Reg. No. 2,923,953) without disclaimer. As stated by the Board in *In re Consolidated Cigar*, 35 U.S.P.Q. 2d 1290, 1295 (T.T.A.B. 1995), "[u]niform treatment under the Trademark Act is desirable." In conformity with its other actions and decisions concerning VOLUME-formative marks, including those examples listed below and the recent publication of L'ORÉAL VOLUME COLLAGENE, the Trademark Office should permit Applicant to register L'ORÉAL EXTRA VOLUME COLLAGENE without a disclaimer of "volume."

The chart below contains examples of current registrations of VOLUME-formative marks for

mascaras that do not disclaim "volume":

Mark	Owner	Reg. No.	Goods
VOLUME SHOCKING	L'Oréal	3,174,583	Mascara
HEALTHY VOLUME	Neutrogena Corp.	3,402,544	Mascara
WONDER VOLUME	Clarins S.A.	3,042,400	Mascara
WEIGHTLESS VOLUME	Neutrogena Corp.	2,595,906	Mascara
VOLUME GLAMOUR	Bourjois	2,563,629	Mascara
FULL VOLUME	Neutrogena Corp.	2,427,571	Mascara
VOLUME EFFECT	Amorepacific Corp.	2,936,930	Mascara and other eye-related personal care products

See Exhibit A.

As illustrated by the foregoing registrations, the term "volume," as it is used in the term now required to be disclaimed, is not *merely descriptive* when used with mascara. Requiring a disclaimer of EXTRA VOLUME COLLAGENE in the application for L'ORÉAL EXTRA VOLUME COLLAGENE would be inconsistent with prior practice and precedent, *see In re Nett Designs*, 57 U.S.P.Q.2d at 1566, and would run afoul of the "practice and precedent" established by the Trademark Office's treatment of similar marks. *In re Merrill Lynch*, 828 F.2d at 1571 (holding that the analysis of whether a mark is descriptive is to be undertaken "in accordance with practice and precedent").

## II. CONCLUSION

In view of the foregoing, Applicant respectfully requests that the disclaimer requirement with respect to the phrase "EXTRA VOLUME COLLAGENE" be withdrawn and that Application Ser. No. 77/477,820 be approved for publication.

[1] Applicant does not concede that L'ORÉAL EXTRA VOLUME COLLAGENE is suggestive. It points out only that the mark is not merely descriptive.

## EVIDENCE

Evidence in the nature of Exhibit A - Registrations Cited in Argument has been attached.

### Original PDF file:

evi\_21624125030-171125277 . Exhibit A -

ROA for L'OREAL EXTRA VOLUME COLLAGENE.pdf

### Converted PDF file(s) (11 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Evidence-5

Evidence-6

Evidence-7

Evidence-8

Evidence-9

Evidence-10

Evidence-11

## **ADDITIONAL STATEMENTS**

### **Claim of Prior Registration(s)**

Applicant claims ownership of U.S. Registration Number(s) 0540541, 0661746.

### **Translation**

The English translation of COLLAGENE in the mark is COLLAGEN.

## **SIGNATURE(S)**

### **Declaration Signature**

I hereby elect to bypass the submission of a signed declaration, because I believe a declaration is not required by the rules of practice. I understand that the examining attorney could still, upon later review, require a signed declaration.

### **Response Signature**

Signature: /bey/ Date: 03/03/2009

Signatory's Name: Bradford E. Young

Signatory's Position: Attorney for Applicant, New York bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 77477820

Internet Transmission Date: Tue Mar 03 17:35:48 EST 2009

TEAS Stamp: USPTO/ROA-216.241.250.30-200903031735482

33355-77477820-44046352a26116bab472ae2e1

6855e649c-N/A-N/A-20090303171125277262



# EXHIBIT A



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## VOLUME SHOCKING

Word Mark	VOLUME SHOCKING
Goods and Services	IC 003. US 001 004 006 050 051 052. G & S: Mascara. FIRST USE: 20051000. FIRST USE IN COMMERCE: 20051000
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	76615292
Filing Date	October 12, 2004
Current Filing Basis	1A
Original Filing Basis	1B
Published for Opposition	December 27, 2005
Registration Number	3174583
Registration Date	November 21, 2006
Owner	(REGISTRANT) L'Oreal SOCIETE ANONYME FRANCE 14, Rue Royale Paris FRANCE 75008
Attorney of Record	Robert L. Sherman
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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## HEALTHY VOLUME

Word Mark	HEALTHY VOLUME
Goods and Services	IC 003. US 001 004 006 050 051 052. G & S: Mascara. FIRST USE: 20071203. FIRST USE IN COMMERCE: 20071203
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	77060956
Filing Date	December 11, 2006
Current Filing Basis	1A
Original Filing Basis	1B
Published for Opposition	April 17, 2007
Registration Number	3402544
Registration Date	March 25, 2008
Owner	(REGISTRANT) Neutrogena Corporation CORPORATION DELAWARE 5760 West 96th Street Los Angeles CALIFORNIA 90045
Attorney of Record	Amy E. Carroll
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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## Typed Drawing

Word Mark	WONDER VOLUME
Goods and Services	IC 003. US 001 004 006 050 051 052. G & S: Cosmetics, namely mascara. FIRST USE: 20050100. FIRST USE IN COMMERCE: 20050100
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	78185248
Filing Date	November 14, 2002
Current Filing Basis	1A
Original Filing Basis	1B
Published for Opposition	July 29, 2003
Registration Number	3042400
Registration Date	January 10, 2006
Owner	(REGISTRANT) Clarins S.A. CORPORATION FRANCE 4, rue Berteaux-Dumas Neuilly-Sur-Seine FRANCE 92200
Attorney of Record	Jess M. Collen
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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## Typed Drawing

Word Mark	WEIGHTLESS VOLUME
Goods and Services	IC 003. US 001 004 006 050 051 052. G & S: Mascara. FIRST USE: 20020115. FIRST USE IN COMMERCE: 20020115
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76236092
Filing Date	April 5, 2001
Current Filing Basis	1A
Original Filing Basis	1B
Published for Opposition	October 9, 2001
Registration Number	2595906
Registration Date	July 16, 2002
Owner	(REGISTRANT) NEUTROGENA CORPORATION CORPORATION DELAWARE 5760 West 96th Street Los Angeles CALIFORNIA 90045
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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## Typed Drawing

Word Mark	VOLUME GLAMOUR
Goods and Services	IC 003. US 001 004 006 050 051 052. G & S: mascaras
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76268397
Filing Date	June 6, 2001
Current Filing Basis	44E
Original Filing Basis	44E
Published for Opposition	January 29, 2002
Registration Number	2563629
Registration Date	April 23, 2002
Owner	(REGISTRANT) Bourjois CORPORATION FRANCE 12/14 rue Victor Noir 92200 Neuilly sur Seine FRANCE
Attorney of Record	SUSAN UPTON DOUGLASS
Prior Registrations	0382154
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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## Typed Drawing

Word Mark	FULL VOLUME
Goods and Services	IC 003. US 001 004 006 050 051 052. G & S: mascara. FIRST USE: 20000501. FIRST USE IN COMMERCE: 20000501
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75733408
Filing Date	June 11, 1999
Current Filing Basis	1A
Original Filing Basis	1B
Published for Opposition	December 28, 1999
Registration Number	2427571
Registration Date	February 6, 2001
Owner	(REGISTRANT) NEUTROGENA CORPORATION CORPORATION DELAWARE 5760 West 96th Street Los Angeles CALIFORNIA 90045
Attorney of Record	AMY E. CARROLL
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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## Typed Drawing

Word Mark	VOLUME EFFECT
Goods and Services	IC 003. US 001 004 006 050 051 052. G & S: mascaras, eye liners, eye shadows, eyebrow pencils, eye lotions, eye makeup remover, adhesives for affixing artificial eyelashes, eye creams, creams for use in the treatment of wrinkled skin. FIRST USE: 20020905. FIRST USE IN COMMERCE: 20021001
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	78240070
Filing Date	April 21, 2003
Current Filing Basis	1A
Original Filing Basis	1B
Published for Opposition	November 4, 2003
Registration Number	2936930
Registration Date	March 29, 2005
Owner	(REGISTRANT) Amorepacific Corporation CORPORATION REPUBLIC OF KOREA 181, 2-ka, Hangang-ro Yongsan-ku Seoul REPUBLIC OF KOREA 140-777
Attorney of Record	Andrew J. Park
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77/477820

**MARK:** L'OREAL EXTRA VOLUME

**\*77477820\***

**CORRESPONDENT ADDRESS:**

ROBERT L. SHERMAN  
PAUL, HASTINGS, JANOFSKY &  
WALKER LLP  
75 E 55TH ST  
NEW YORK, NY 10022-3404

**GENERAL TRADEMARK INFORMATION:**  
<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** L'Oreal

**CORRESPONDENT'S REFERENCE/DOCKET  
NO:** 29172.00012

**CORRESPONDENT E-MAIL ADDRESS:**  
[rls@paulhastings.com](mailto:rls@paulhastings.com)

**EXAMINER'S AMENDMENT**

**ISSUE/MAILING DATE:** 3/25/2009

**AMENDMENT:** In accordance with the authorization granted by Mr. Bradford E. Young on March 25, 2009, the application has been AMENDED as indicated below. Please advise the undersigned examining attorney immediately if there is an objection to the amendment. *Otherwise, no response is necessary.* TMEP §707.

**REQUIREMENTS WITHDRAWN**

The following requirements have been satisfied: (1) the requirement to submit a translation of the foreign wording in the mark; (2) the requirement to claim ownership of applicant's prior registrations; and (3) the

disclaimer requirement (see amendment below). TMEP §713.02.

**AMENDMENT OF DISCLAIMER STATEMENT**

The disclaimer statement is amended to read as follows:

**No claim is made to the exclusive right to use “COLLAGENE” apart from the mark as shown.**

15 U.S.C. §1056; TMEP §§1213, 1213.03(a), 1213.08(a)(i).

**If there are any questions about this Examiner’s Amendment, please contact the undersigned examining attorney.**

/Robert J. Lavache/  
Examining Attorney  
Law Office 108  
Phone: (571) 272-5881  
Fax: (571) 273-9108

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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**To:** L'Oreal ([rls@paulhastings.com](mailto:rls@paulhastings.com))  
**Subject:** TRADEMARK APPLICATION NO. 77477820 - L'OREAL EXTRA  
VOLUME - 29172.00012  
**Sent:** 3/25/2009 1:43:46 PM  
**Sent As:** ECOM108@USPTO.GOV  
**Attachments:**

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**IMPORTANT NOTICE**  
**USPTO OFFICE ACTION HAS ISSUED ON 3/25/2009 FOR**  
**APPLICATION SERIAL NO. 77477820**

Please follow the instructions below to continue the prosecution of your application:

**VIEW OFFICE ACTION:** Click on this link  
[http://tmpportal.uspto.gov/external/portal/tow?DDA=Y&serial\\_number=77477820&doc\\_type=EXA&](http://tmpportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77477820&doc_type=EXA&)  
(or copy and paste this URL into the address field of your browser), or visit  
<http://tmpportal.uspto.gov/external/portal/tow> and enter the application serial number to access the  
Office action.

**PLEASE NOTE:** The Office action may not be immediately available but will be viewable within 24 hours of this notification.

**RESPONSE MAY BE REQUIRED:** You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable response time period. Your response deadline will be calculated from 3/25/2009.

**Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.**

**HELP:** For *technical* assistance in accessing the Office action, please e-mail [TDR@uspto.gov](mailto:TDR@uspto.gov). Please contact the assigned examining attorney with questions about the Office action.

**WARNING**

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the**

**ABANDONMENT of your application.**

UNITED STATES PATENT AND TRADEMARK OFFICE

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Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451  
[www.uspto.gov](http://www.uspto.gov)

Apr 8, 2009

**NOTICE OF PUBLICATION UNDER 12(a)**

- |                                      |   |
|--------------------------------------|---|
| 1. Serial No.:<br>77/477,820         | 2. Mark:<br>L'OREAL EXTRA VOLUME COLLAGENE<br>Standard Character Mark |
| 3. International Class(es):<br>3     |   |
| 4. Publication Date:<br>Apr 28, 2009 | 5. Applicant:<br>L'Oreal  |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a notice of allowance pursuant to section 13(b) of the Statute.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents  
U.S. Government Printing Office  
PO Box 371954  
Pittsburgh, PA 15250-7954  
Phone: 202-512-1800

By direction of the Commissioner.

---

Correspondence Address:



ROBERT L. SHERMAN  
PAUL, HASTINGS, JANOFSKY & WALKER LLP  
75 E 55TH ST  
NEW YORK, NY 10022-3404

· TMP&I

U.S. Patent and Trademark Office (USPTO)

**NOTICE OF ALLOWANCE**

NOTE: If any data on this notice is incorrect, please fax a request for correction to the Intent to Use Unit at 571-273-9550. Please include the serial number of your application on ALL correspondence with the USPTO.

ISSUE DATE: Jul 21, 2009

ROBERT L. SHERMAN  
PAUL, HASTINGS, JANOFSKY & WALKER LLP  
75 E 55TH ST  
NEW YORK, NY 10022-3404

ATTORNEY  
REFERENCE NUMBER

29172.00012

**\*\* IMPORTANT INFORMATION: 6 MONTH DEADLINE \*\***

You filed the trademark application identified below based upon a bona fide intention to use the mark in commerce. You must use the mark in commerce and file a Statement of Use (a.k.a. Allegation of Use) before the USPTO will register the mark. You have six (6) MONTHS from the ISSUE DATE of this Notice of Allowance (NOA) to file either a Statement of Use, or if you are not yet using the mark in commerce, a Request for Extension of Time to File a Statement of Use ("Extension Request"). If you file an extension request, you must continue to file a new request every six months until the Statement of Use is filed. Applicant may file a total of five (5) extension requests. FAILURE TO FILE A REQUIRED DOCUMENT DURING THE APPROPRIATE TIME PERIOD WILL RESULT IN THE ABANDONMENT OF YOUR APPLICATION. Please note that both the "Statement of Use" and "Extension Request" have many legal requirements including fees. Therefore, we encourage use of the USPTO forms, available online at <http://www.uspto.gov/teas/index.html> (under "File a PRE-registration form"), to avoid the possible omission of important information. Please note that the Trademark Electronic Application System (TEAS) provides line-by-line help instructions for completing the Extension Request or Statement of Use forms online. If you do not have access to the Internet, you may call 1-800-786-9199 to request the printed form(s).

**\*\* Registration Subject to Cancellation for Fraudulent Statements \*\***

Ensure that statements made in filings to the USPTO are accurate, as inaccuracies may result in the cancellation of your trademark registration. The lack of a bona fide intention to use the mark with all goods and/or services included in an application or the lack of use on all goods and/or services for which you claimed use could jeopardize the validity of your registration, possibly resulting in its cancellation.

**The following information should be reviewed for accuracy:**

SERIAL NUMBER:

77/477820

MARK: L'OREAL EXTRA VOLUME COLLAGENE (STANDARD CHARACTER MARK)  
OWNER: L'Oreal  
14 rue Royale  
Paris , FRANCE 75008

This application has the following bases, but not necessarily for all listed goods/services:

Section 1(a): NO

Section 1(b): YES

Section 44(e): NO

### **GOODS/SERVICES BY INTERNATIONAL CLASS**

003 - Mascaras -- FIRST USE DATE: NONE; -- USE IN COMMERCE DATE: NONE

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

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**ADDITIONAL INFORMATION MAY BE PRESENT IN THE USPTO RECORDS**

## Post-Publication Amendment

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77477820
LAW OFFICE ASSIGNED	LAW OFFICE 108
<b>MARK SECTION (current)</b>	
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	L'OREAL EXTRA VOLUME COLLAGENE
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>MARK SECTION (proposed)</b>	
MARK	<u>L'OREAL EXTRA VOLUME COLL AGEN</u>
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	L'OREAL EXTRA VOLUME COLLAGEN
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>EXPLANATION OF FILING</b>	
Applicant would like to change the word COLLAGENE to COLLAGEN.	
<b>SIGNATURE SECTION</b>	
RESPONSE SIGNATURE	/rls/
SIGNATORY'S NAME	Robert L. Sherman
SIGNATORY'S POSITION	Attorney of Record, NY Bar Member
DATE SIGNED	01/21/2010
AUTHORIZED SIGNATORY	YES
<b>FILING INFORMATION SECTION</b>	

<b>SUBMIT DATE</b>	Thu Jan 21 11:56:22 EST 2010
<b>TEAS STAMP</b>	USPTO/PPA-216.241.250.30- 20100121115622886463-7747 7820-4609661b721c8284ba5e fdac41f3b957da-N/A-N/A-20 100120154036384956

100120154036384956

### **Post-Publication Amendment**

#### **To the Commissioner for Trademarks:**

Application serial no. **77477820** has been amended as follows:

#### **MARK**

**Applicant proposes to amend the mark as follows:**

**Current:** L'OREAL EXTRA VOLUME COLLAGENE (standard characters)

**Proposed (USPTO generated image):** L'OREAL EXTRA VOLUME COLLAGEN (Standard Characters, see [mark](#))

The mark consists of standard characters, without claim to any particular font, style, size, or color.

#### **EXPLANATION OF FILING**

Applicant would like to change the word COLLAGENE to COLLAGEN.

#### **SIGNATURE(S)**

Signature: /rls/ Date: 01/21/2010

Signatory's Name: Robert L. Sherman

Signatory's Position: Attorney of Record, NY Bar Member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 77477820

Internet Transmission Date: Thu Jan 21 11:56:22 EST 2010

TEAS Stamp: USPTO/PPA-216.241.250.30-201001211156228

86463-77477820-4609661b721c8284ba5efdac4

1f3b957da-N/A-N/A-20100120154036384956

# L'OREAL EXTRA VOLUME COLLAGEN

## Trademark/Service Mark Statement of Use (15 U.S.C. Section 1051(d))

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77477820
LAW OFFICE ASSIGNED	LAW OFFICE 108
EXTENSION OF USE	NO
MARK SECTION	
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	L'OREAL EXTRA VOLUME COLLAGENE
OWNER SECTION (no change)	
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	003
CURRENT IDENTIFICATION	Mascaras
GOODS OR SERVICES	KEEP ALL LISTED
FIRST USE ANYWHERE DATE	04/00/2009
FIRST USE IN COMMERCE DATE	04/00/2009
SPECIMEN FILE NAME(S)	<u>\\TICRS\EXPORT9\IMAGEOUT9</u> <u>\774\778\77477820\xml2\SO U0002.JPG</u>
SPECIMEN DESCRIPTION	photograph of product
REQUEST TO DIVIDE	NO
PAYMENT SECTION	
NUMBER OF CLASSES IN USE	1
SUBTOTAL AMOUNT [ALLEGATION OF USE FEE]	100
TOTAL AMOUNT	100



<b>SIGNATURE SECTION</b>	
<b>DECLARATION SIGNATURE</b>	/José MONTEIRO/
<b>SIGNATORY'S NAME</b>	José MONTEIRO
<b>SIGNATORY'S POSITION</b>	Chief Trademark Counsel
<b>DATE SIGNED</b>	01/21/2010
<b>FILING INFORMATION</b>	
<b>SUBMIT DATE</b>	Thu Jan 21 12:01:01 EST 2010
<b>TEAS STAMP</b>	USPTO/SOU-216.241.250.30- 20100121120101303684-7747 7820-46034a744f06ec7876e8 4ba1a572eb77e1-DA-9186-20 100120160002747244

**Trademark/Service Mark Statement of Use  
(15 U.S.C. Section 1051(d))**

To the Commissioner for Trademarks:

**MARK:** L'OREAL EXTRA VOLUME COLLAGENE  
**SERIAL NUMBER:** 77477820

The applicant, L'Oreal, having an address of  
14 rue Royale  
Paris, 75008  
France

is submitting the following allegation of use information:

For International Class 003:  
Current identification: Mascaras

The mark is in use in commerce on or in connection with all goods or services listed in the application or Notice of Allowance or as subsequently modified for this specific class

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in

interest at least as early as 04/00/2009, and first used in commerce at least as early as 04/00/2009, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) photograph of product.  
Specimen File1

The applicant is not filing a Request to Divide with this Allegation of Use form.  
A fee payment in the amount of \$100 will be submitted with the form, representing payment for the allegation of use for 1 class.

### **Declaration**

Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). Applicant is the owner of the mark sought to be registered, and is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the form or any resulting registration, declares that he/she is properly authorized to execute this form on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the form is being filed under 15 U.S.C. Section 1126(d) or (e), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /José MONTEIRO/     Date Signed: 01/21/2010  
Signatory's Name: José MONTEIRO  
Signatory's Position: Chief Trademark Counsel

RAM Sale Number: 9186  
RAM Accounting Date: 01/21/2010

Serial Number: 77477820  
Internet Transmission Date: Thu Jan 21 12:01:01 EST 2010  
TEAS Stamp: USPTO/SOU-216.241.250.30-201001211201013  
03684-77477820-46034a744f06ec7876e84ba1a  
572eb77e1-DA-9186-20100120160002747244

L'OREAL  
PARIS

675

BLACK  
NOIR

# EXTRA-VOLUME COLLAGEN

Hydra  
Collagen  
Plumping  
Mascara

All Day Wear:

- ⊗ No Clumps
- ⊗ No Flakes
- ⊗ No Smudges

Mascara  
galbant  
à l'hydra-  
collagène

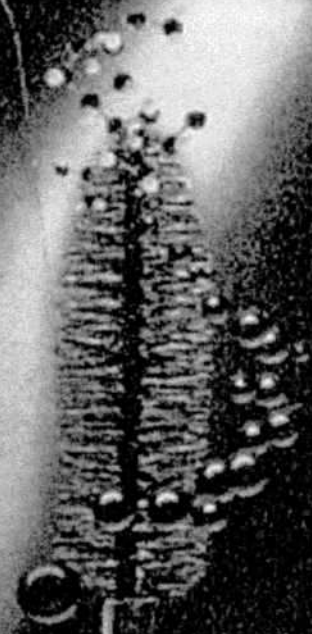
Résiste toute la journée

• Sans grumeaux

• Ne s'écaille pas

• Ne coule pas

by



**NEW**

**12x** More  
Impact Instantly

**NOUVEAU**

**12x plus  
de volume  
instantanément**

**INSTANT  
IMPACT BRUSH**  
Custom Designed  
to Grab Each  
and Every Lash

# L'OREAL EXTRA VOLUME COLLAGEN

L'ORÉAL  
PARIS

675

BLACK  
NOIR

# EXTRA-VOLUME COLLAGEN

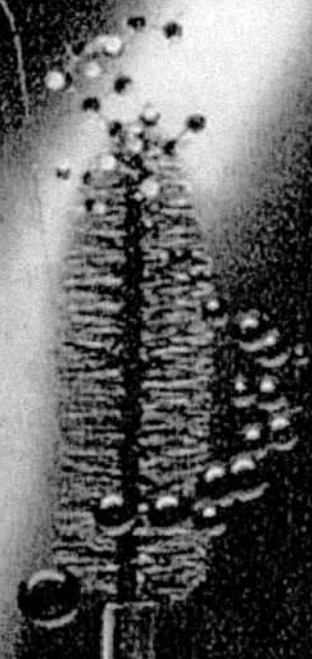
Hydra  
Collagen  
Plumping  
Mascara

All Day Wear:  
⊗ No Clumps  
⊗ No Flakes  
⊗ No Smudges

Mascara  
galbant  
à l'hydra-  
collagène

Resiste toute la jour-  
née  
⊗ Sans grumeaux  
⊗ Ne s'écaille pas  
⊗ Ne coule pas

by



**NEW**

**12x** More  
Impact Instantly

**NOUVEAU**

**12x plus  
de volume  
instantanément**

**INSTANT  
IMPACT BRUSH**  
Custom Designed  
to Grab Each  
and Every Lash

# FEE RECORD SHEET

Serial Number: 77477820



RAM Sale Number: 9186

Total Fees: \$100

RAM Accounting Date: 20100121

<u>Transaction</u>	<u>Fee Code</u>	<u>Transaction Date</u>	<u>Fee per Class</u>	<u>Number of Classes</u>	<u>Total Fee</u>
Statement of Use (SOU)	7003	20100121	\$100	1	\$100

Transaction Date: 20100121



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**To:** L'Oreal ([rls@paulhastings.com](mailto:rls@paulhastings.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77477820 - L'OREAL EXTRA VOLUME COLLAGEN - 29172.00012  
**Sent:** 3/18/2010 4:26:32 PM  
**Sent As:** ECOM108@USPTO.GOV  
**Attachments:**

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77/477820

**MARK:** L'OREAL EXTRA VOLUME COLLAGEN

**\*77477820\***

**CORRESPONDENT ADDRESS:**

ROBERT L. SHERMAN  
PAUL, HASTINGS, JANOFSKY & WALKER  
LLP  
75 E 55TH ST  
NEW YORK, NY 10022-3404

**RESPOND TO THIS ACTION:**

<http://www.uspto.gov/teas/eTEASpageD.htm>

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** L'Oreal

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

29172.00012

**CORRESPONDENT E-MAIL ADDRESS:**

[rls@paulhastings.com](mailto:rls@paulhastings.com)

**OFFICE ACTION**

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

**ISSUE/MAILING DATE:** 3/18/2010

The statement of use has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

**POST-PUBLICATION AMENDMENT**

Applicant's post-publication amendment to the mark drawing, which was filed on January 21, 2010, is acknowledged and accepted. Please note, however, that the amendment to the mark drawing necessitates an amendment to the current disclaimer statement and deletion of the current translation statement. Please see the requirements set forth below for further information.

### **MARK DIFFERS ON DRAWING AND SPECIMEN**

The mark on the specimen disagrees with the mark on the drawing. In this case, the specimen submitted with the statement of use displays the mark as "L'OREAL PARIS EXTRA-VOLUME COLLAGEN," while the drawing (as amended) shows the mark as "L'OREAL EXTRA VOLUME COLLAGEN."

A statement of use must include a specimen showing the applied-for mark in use in commerce for each class of goods and/or services specified in the statement of use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2); TMEP §§904, 1109.09(b). The mark on the drawing must be a substantially exact representation of the mark as used on the specimen. 37 C.F.R. §2.51(b); TMEP §807.12(a); *see* 37 C.F.R. §2.72(b)(1).

The drawing of the mark can be amended only if the amendment does not materially alter the mark as originally filed. 37 C.F.R. §2.72(a)(2), (b)(2); TMEP §§807.12(a), 807.14 *et seq.* However, in this case, amending the mark in the drawing to conform to the mark on the specimen would be a material alteration because the addition of the wording "PARIS" to the mark on the specimen creates a different commercial impression from the mark on the drawing. (Please note that it would not be a material alteration to amend the wording "EXTRA VOLUME" (without hyphen) to "EXTRA-VOLUME" (with hyphen), as it is shown on the specimen.)

Therefore, applicant must submit the following:

- (1) A substitute specimen showing use in commerce of a substantially exact representation of the mark on the drawing. *See* 37 C.F.R. §2.59(b)(1); TMEP §904.05.; and
- (2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §§2.20, 2.33: **"The substitute specimen was in use in commerce prior to the expiration of the time allowed applicant for filing a statement of use."** *See* 37 C.F.R. §2.59(b)(2); TMEP §904.05. If submitting a specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

Examples of specimens for goods are tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, or displays associated with the actual goods at their point of sale. *See* TMEP §§904.03 *et seq.*

Pending receipt of a proper response, registration is refused because the specimen does not show the applied-for mark in use in commerce as a trademark. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2); TMEP §§904, 904.07(a).

Applicant may not withdraw the statement of use. 37 C.F.R. §2.88(g); TMEP §1109.17.



**Applicant's response must also satisfy the following requirements:**

**AMENDMENT OF DISCLAIMER STATEMENT**

The application currently contains a disclaimer of the word "COLLAGENE." However, applicant has amended the mark drawing to replace the word "COLLAGENE" with "COLLAGEN." As such, applicant must amend the disclaimer statement to disclaim "COLLAGEN." *See* 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a). Please see the previously attached dictionary evidence, showing the descriptive significance of the wording "collagen."

Applicant may satisfy this requirement by submitting the following amended disclaimer statement:

**No claim is made to the exclusive right to use "COLLAGEN" apart from the mark as shown.**

TMEP §1213.08(a)(i); *see In re Owatonna Tool Co.*, 231 USPQ 493 (Comm'r Pats. 1983).

**DELETION OF TRANSLATION STATEMENT**

The applicant currently contains the following translation statement: *The English translation of "COLLAGENE" in the mark is "collagen."*

However, because the mark drawing has been amended to replace the foreign wording "COLLAGENE" with the English wording "COLLAGEN," the translation statement is no longer required and should be withdrawn and deleted from the application record. *See* TMEP §§809, 809.03. Applicant may satisfy this requirement by submitting a statement indicating that applicant wishes to withdraw and delete the translation statement.

**If there are any questions about this Office action, please contact the undersigned examining attorney.**

/Robert J. Lavache/  
Examining Attorney  
Law Office 108  
Phone: (571) 272-5881  
Fax: (571) 273-9108

**RESPOND TO THIS ACTION:** Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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**To:** L'Oreal ([rls@paulhastings.com](mailto:rls@paulhastings.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77477820 - L'OREAL EXTRA VOLUME COLLAGEN - 29172.00012  
**Sent:** 3/18/2010 4:26:33 PM  
**Sent As:** ECOM108@USPTO.GOV  
**Attachments:**

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## **IMPORTANT NOTICE REGARDING YOUR TRADEMARK APPLICATION**

**Your trademark application (Serial No. 77477820) has been reviewed. The examining attorney assigned by the United States Patent and Trademark Office (“USPTO”) has written a letter (an “Office action”) on 3/18/2010 to which you must respond (*unless the Office letter specifically states that no response is required*). Please follow these steps:**

**1. Read the Office letter by clicking on this [link](http://tmpportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77477820&doc_type=OOA&)**

**OR go to <http://tmpportal.uspto.gov/external/portal/tow> and enter your serial number to access the Office letter. If you have difficulty accessing the Office letter, contact [TDR@uspto.gov](mailto:TDR@uspto.gov).**

**PLEASE NOTE:** The Office letter may not be immediately available but will be viewable within 24 hours of this e-mail notification.

**2. Contact the examining attorney who reviewed your application if you have any questions about the content of the Office letter (contact information appears at the end thereof).**

**3. Respond within 6 months, calculated from 3/18/2010 (*or sooner if specified in the Office letter*), using the Trademark Electronic Application System (TEAS) [Response to Office Action form](#). If you have difficulty using TEAS, contact [TEAS@uspto.gov](mailto:TEAS@uspto.gov).**

### **ALERT:**

**Failure to file any required response by the applicable deadline will result in the ABANDONMENT (loss) of your application.**

**Do NOT hit “Reply” to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses.**